PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Newnam et al.	Examiner:	R. Alvarez
Serial No.:	09/536,518	Technology Center:	3600
Filed:	March 22, 2000	Art Unit:	3622
Entitled:	**A Method and System of Playing and Controlling a Contest for a Large Number of Simultaneous Contestants**	Confirmation No.:	2014
		Atty. Docket No.:	109779-135

CERTIFICATION UNDER 37 C.F.R. § 1.10

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April 13, 2004
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APPEAL BRIEF UNDER 37 C.F.R. § 1.192

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
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Dear Sir:

This is an Appeal Brief pursuant to the Notice of Appeal filed on February 13, 2004, appealing the rejection of claims 1-16 in the Office Action of November 18, 2003. This Brief is being filed in triplicate.

I. REAL PARTY IN INTEREST

The real party in interest is GoldPocket Interactive, Inc., the assignee of the present application.

II. RELATED APPEALS AND INTERFERENCES

The Appellants, the Appellants' legal representatives, and the Assignee are not aware of any pending appeal or interference that would directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF THE CLAIMS

Claims 1-16 are pending in the application, and have been twice rejected. Claims 17-18 were canceled during prosecution. Claims 1-16 are appealed.

IV. STATUS OF AMENDMENTS

The claims were first rejected in an Office Action of September 27, 2002. An in-person interview with the Examiner was held on October 28, 2002. The claims were amended in a Reply under 37 C.F.R. § 1.111 dated March 25, 2003. Included with the Reply were two declarations under 37 C.F.R. § 1.132 and seven supporting exhibits. In an Office Action of September 10, 2003, the Examiner announced a restriction requirement under 35 U.S.C. § 121. The applicant elected claims 1-16 without traverse and reserved the right to file divisional applications for non-elected claims 17-18. Claims 1-16 were rejected in an Office Action of November 18, 2003 (hereinafter "Office Action"). No subsequent amendment has been submitted. A copy of the pending claims is attached as Appendix A, and, for the Board's convenience, copies of the Office Action of November 18, 2003, and the Reply of March 25, 2003, are attached as Appendix B and Appendix D, respectively.[1]

V. SUMMARY OF THE INVENTION

Claim 1 is an independent claim that recites the core limitations for all the claims at issue. In particular, claim 1 recites a method to conduct a new kind of "skill-based contest" that begins for every one of "a large multitude of contestants" at a "fixed start time" but nonetheless produces a "unique winner" "in a fixed, short amount of time." App. A, at p. 1. The result is a

[1] The single prior-art reference relied on by the Examiner in rejecting the claims is attached as Appendix C. Declarations of Professor Ryan Nelson and Dr. Leszek Pawlowicz were submitted to the Examiner with the Reply and are attached, for the Board's convenience, as Appendices E and F, respectively. The Appendices are cited herein as "App. __." Attachments A-K of the Reply are included in Appendix D and cited herein as "App. D, att. __".

skill-based competition with a single winner that proceeds on a scale (potentially involving, for example, on the order of millions of contestants) and at a speed (concluding within, for example, one hour) that are together unprecedented.[2] *See* Specification, at p. 5, ll. 8-10; p. 7, ll. 16-19; p. 8, ll. 1-2, p. 8, l. 15, to p. 9, l. 4. Such a contest is significantly different from prior-art skill-based games such as (1) small, generally private contests not requiring a pre-selection process for participants; (2) contests broadcast to a general audience, but involving only a comparatively small number of pre-selected contestants; and (3) prior "massive multiplayer online games" ("MMOGs"), which were generally role-playing games lacking any definite end time and lacking any methodology for determining "a single winner from a large pool of contestants in 'head-to-head' competition." *Id.* at p. 1, ll. 10-15; p. 3, l. 16, to p. 5, l. 10; *see also* App. D, att. E. The invention's revolutionary nature has caused the *Wall Street Journal* to report that "Internet veterans agree" that such an invention "***adds a new dimension*** to the Web," App. D, att. G, at pp. 1-2 (emphasis added); has led an information-systems expert to declare that the invention provides an experience "***truly unique*** in the annals of 'mass participative communication,'" App. E, at ¶ 13 (emphasis added); and has led an expert on skill-based games to describe the invention as producing a contest "***fundamentally different***" from prior games, App. F, at ¶ 9 (emphasis added).

The invention achieves these unprecedented results by a method that combines a number of critical, although perhaps individually innocuous, steps in a way whose potential, in combination with a "communication network," had not been previously appreciated or realized. App. E, at ¶ 14; App. F, at ¶ 12. In particular, claim 1, the application's only pending independent claim, recites use of a "communication network" to conduct a "skill-based contest" that "begins for all contestants at a fixed start time and converges to [a] unique winner in a fixed, short amount of time" by engaging the contestants in successive rounds of subcompetitions. App. A, at p. 1. The method comprises multiple steps:

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[2] The Reply of March 25, 2003, pointed out that the phrase "large multitude," which "generally refers to games having an extraordinary number of contestants," has "clear meaning in the relevant art." App. D, at p. 4, ll. 9-20. This art defines the related term "Massive Multiplayer Online Game (MMOG)" as a "kind of online game that allows a huge number of players (greater than 1,000) to play in the same game concurrently." App. D, att. E. Further, as noted in the Reply, the Specification explains the basic nature of the "large multitude" and "short time" limitations, saying that "exemplary methods allow on the order of millions of contestants," but exemplary contests "end in about an hour." App. D, at p. 4, ll. 11-13; p. 5, ll. 19-20.

a. "identifying a large multitude of contestants";

b. "grouping the contestants into group subsets according to group criteria"'

c. "matching contestants within the group subsets into subcompetitions";

d. "presenting a competition task" for each subcompetition;

e. "monitoring responses" to competition tasks and "determining a subcompetition outcome status of each contestant";

f. grouping "at least some" contestants based on "group criteria or subcompetition outcome status," or both; and

g. repeating steps c through f "until there is a unique winner."

App. A, at p. 1. The dependent claims add requirements that, for example, govern details of how the competition is conducted, including the award of prizes (*see, e.g.*, claims 2-3, 5-7, 12-14, 16); demand or enable use of contestant responses and behavior to compile information about individuals or about groups of contestants (*see, e.g.*, claims 8-11, 15); or require the use of a "server node" and "time stamping" at "contestant nodes" to track the times that contestants use to respond (*see, e.g.*, claim 4).[3] App. A, at pp. 1-4.

VI. ISSUE

In view of various "officially noticed" propositions, are claims 1-16 obvious under 35 U.S.C. §103(a) over a newswire article entitled, in part, "NetPlay: NetPlay Debuts Internet's Premier Multi-Player Entertainment Network"?

VII. GROUPING OF CLAIMS

Except for claims 9 and 10, the claims presented on appeal do not stand or fall together. Other than claims 9 and 10, each of the claims recites a distinct combination of required elements that is separately patentable from the other claims.

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[3] The Specification discusses various embodiments illustrating implementations of claim elements. *See, e.g., id.* at p. 17, ll. 18-22 (describing the operation of preferred embodiments); p. 18, l. 14, to p. 19, l. 6 (same); p. 10, ll. 11-22 (discussing an embodiment using "contestant node[s]" and an "Event Engine" that is "preferably a web-based server system"); *id.* at p. 15, ll. 4-12 (describing an embodiment's capacity to compile user profiles or statistical data about users); *id.* at p. 15, ll. 14-22 (discussing an embodiment's capacity to award prizes, such as "click on" electronic coupons, based on "points"); *id.*, at p. 18, ll. 3-5 (describing an embodiment's allowance of a "time window" "(e.g., ten seconds)" for contestant responses); *id.* at p. 24, l. 18, to p. 25, l. 2 (describing use of a "timestamp feature" in an embodiment); *id.* at p. 28, ll. 7-11 (discussing an embodiment's "ability to serve 'branded' questions").

VIII. SUMMARY OF ARGUMENT

Claims 1 through 16 are not obvious over any combination of officially noticed facts and the only specific reference cited by the Examiner: the newswire article "NetPlay: NetPlay Debuts Internet's Premier Multi-Player Entertainment Network; NetPlay Game Club Brings People Together To Create Broad-Based, Online Community" (hereinafter "the NetPlay article").

The Examiner has failed to establish a *prima facie* case of obviousness. The NetPlay article is a "Business Wire" article that does not disclose any of the key elements of the claimed invention: for example, (1) contests involving simultaneous play by a "large multitude," or (2) a method for conducting and monitoring subcompetitions to determine a "unique winner" from such a multitude in a short time. Nor does the article disclose any of the combinations of limitations required by the 15 dependent claims at issue. As a result of the NetPlay article's clear deficiencies, the Examiner has relied on "official notice" to identify not only isolated elements of the invention but also motivations to combine, and has sought these elements and motivations in scattered or non-specific "prior art" – *e.g.*, "competition"; "world series games, such as baseball"; "spelling-bee"; and "marketing." App. B, at pp. 3-6. The Examiner's reliance on official notice and conclusory assertions of obviousness is improper: first, because the Examiner "notices" propositions that are in fact disputable, *cf. Anderson v. Eppstein*, 59 U.S.P.Q.2d 1280, 1287 (Bd. Pat. App. & Interf. 2001); second, because the Examiner uses official notice and conclusory analysis to make "core factual findings in a determination of patentability," *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001); and third, because the Examiner's combined use of official notice and conclusory analysis is the very essence of forbidden hindsight reasoning – the use of "hindsight reconstruction to pick and choose among isolated disclosures ... to deprecate the claimed invention," *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

Indeed, although individual elements of the claimed invention may, in isolation, appear simple, evidence presented to the Examiner – including a *Wall Street Journal* article and sworn declarations from two experts – clearly shows that the invention's ***combination*** of elements was nonobvious and truly revolutionary. *Cf. McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351 (Fed. Cir. 2001) ("The genius of invention is often a combination of known elements which in hindsight seems preordained."). Nobody had previously realized how this combination could be used to add what the *Wall Street Journal* described as "a new dimension to the Web," App. D,

att. G, at pp. 1-2. Because of the claimed invention, a ***broadcast-level number*** of individual contestants – potentially millions – have for the first time been able to compete actively and simultaneously in a skill-based game that quickly yields a unique winner. *See* Specification, at p. 3, l. 16, to p. 5, l. 10. As with the first winner of a contest embodying the claimed invention, App. D, att. G, at p. 2, such individuals can come as they are to a single-winner competition ***truly open to all***, and they can prevail not just because of the "way the ball bounces," not in substantial part because they were among a comparative few with time and resources to undergo an involved pre-selection process, but instead because of their own true skill. *Cf.* Specification, at p. 1, l. 21, to p. 2, l. 3. For such reasons, Professor Ryan Nelson, an expert on information systems, and Dr. Leszek Pawlowicz, an expert in competitive games, have recognized that the claimed invention recites a combination of elements "fundamentally different" from prior-art "internet-based systems" or prior-art "games." App. E, at ¶ 10; App. F, at ¶ 9. They have determined that the invention is "unique, new and not obvious." App. E, at ¶ 10; App. F, at ¶ 9. The Examiner has identified no statement or teaching to the contrary.

IX. ARGUMENT

A. The Examiner Failed to Make a *Prima Facie* Case of Obviousness With Respect to Claim 1 – and Thus With Respect to Any of the Claims at Issue.

1. The Examiner Has Failed to Point to Any Specific, Prior Understandings That Suggested Claim 1's Combination of Contest Scale, Speed and Form, and Has Wrongly Relied on Hindsight to Declare Claim 1 Obvious.

Before rejecting an invention that is not anticipated and that, at the very least, requires a combination of elements from different prior-art references, an Examiner must "explain what *specific* understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination." *In re Rouffet*, 149 F.3d 1350, 1357-58 (Fed. Cir. 1998) (emphasis added). Motivation to combine cannot be found based on "conclusory statements," "subjective belief," or "unknown authority," but must instead be found in a "'specific hint or suggestion'" that predates the invention. *In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002).

In this case, the Examiner has failed to establish such motivation with respect to any claim at issue. Instead, the Examiner has rejected claim 1's core limitations – reciting a method for conducting a massive, strictly time-limited, skill-based contest – based on no more than:

1) the NetPlay article – a single, short "Business Wire" article describing "an online, multi-player entertainment community" that not only bears no resemblance to the claimed invention, but in fact teaches against the invention's emphasis on rapid-fire, competition-driven contests involving a "large multitude," *see infra*, at p. 8; and

2) "official notice" of propositions – *e.g.*, that retail sellers award prizes, and that "includ[ing] a large number of contestants ... make[s] the competition more fierc[e]," App. B, at pp. 3, 5-6 – that either are disputable or lack any clear relation to the particular combination of elements at issue, *see infra*, at pp. 9-11.

In effect, the Examiner's use of official notice to supplement an obviously deficient reference amounts to taking "official notice" that the invention is obvious – without any evidence that prior art ever suggested a combination like that of the invention.[4] Such hindsight reasoning cannot be the basis for a valid *prima facie* case of obviousness. *In re Fine*, 837 F.2d at 1075. Indeed, the Examiner's reliance on official notice and conclusory reasoning to establish obviousness is forbidden: "With respect to core factual findings in a determination of patentability," conclusions must be based on "concrete evidence in the record" and not merely one's "own understanding or experience – or [one's own] assessment of what would be basic knowledge or common sense." *In re Zurko*, 258 F.3d at 1386; *see also In re Lee*, 277 F.3d at 1343-44.

2. The NetPlay Article Discloses Nothing Close to Claim 1's Sharply Time-Limited, Massive Multi-Player Contest and Even Teaches Against the Interest in "Fierc[e]" Competition That the Examiner Alleges Provided Motivation to Modify NetPlay to Permit a "Large Multitude of Contestants."

The NetPlay article is a nine-paragraph newswire article describing "an online, multi-player entertainment community." App. C, at p. 1. The article does not disclose any capacity to engage a "large multitude" in simultaneous competition – never mind competition that produces a "unique winner" from such a "multitude" within a "fixed, short amount of time" beginning from

[4] The Examiner cites a 1955 Court of Customs and Patent Appeals' opinion, *In re Rose*, 220 F.2d 459, 463 (C.C.P.A. 1955), for its statement that a particular limitation "at most relate[d] to the size of the article under consideration which is not ordinarily a matter of invention." App. B, at p. 6. But *Rose* did not thereby establish a *per se* rule that any change in scale is obvious. *Cf. Gardner v. TEC Sys., Inc.*, 725 F.2d 1338, 1347-49 (Fed. Cir. 1984) (performing substantive analysis of whether "dimensional limitations" made any "significant difference"). Moreover, the invention here is a method, not a physical "article" like the "lumber package" of *In re Rose*, 220 F.2d at 460-61. Further, the claimed method does not represent a mere design choice that can be produced by simply "scal[ing] up," *In re Rinehart*, 531 F.2d 1048, 1052-53 (C.C.P.A. 1976), the NetPlay reference. *See infra*, at pp. 7-11. Instead, the "dimensional limitations" at issue here involve "'qualitatively different phenomena,'" *Gardner*, 725 F.2d at 1346. As two experts attest, the differences between the claimed invention and prior art such as NetPlay amount to a vast change in kind, rather than a trivial difference in degree. App. E, at ¶¶ 10-14; App. F, at ¶¶ 9-13.

a "fixed start time."[5] The impossibility of using NetPlay even to suggest such a contest is proven by an exhibit from NetPlay's website that was submitted to the Examiner. This exhibit proudly states, "Play these games with *up to six people*!" – an exclamation that demonstrates just how far beyond any suggestion or teaching in NetPlay was a kind of massive multi-player contest that could involve millions. App. D, att. F, at p. 1 (emphasis added).

Indeed, if anything, the NetPlay article ***teaches away*** from such a competition and teaches instead the desirability of cozily social entertainment quite at odds with the invention's rapid-fire, massive multi-player contest. Hence, after citing Poker, Crazy 8s, and Hot Potato as examples of games available on NetPlay, the article states that "[e]very game comes with an intuitive interface and chat function that lets members socialize while they're playing." App. C, at p. 1. In this vein, the NetPlay article emphasizes NetPlay's aim to establish an "entertainment *community*" "for people ready to move beyond the 'blood and guts' mentality found in many online gaming networks." *Id.* (emphasis added). The exhibit from NetPlay's website confirms that NetPlay "lets you see and chat with other players ... *for hours* of highly social, family-safe fun!" App. D, att. F, at p. 1 (emphasis added). By such explicit emphasis on socialization, "clubbiness," and the opportunity "for hours" of interaction, the NetPlay article disparages interest in "mak[ing] the competition more fierc[e]" – the sole motivation cited as providing reason to alter NetPlay to permit a "large multitude" of contestants, App. B, at p. 3.

Finally, the weakness of the NetPlay article as a prior-art reference is illustrated not only by the Examiner's use of "official notice" to try to supplement the article's disclosure, but also by the Examiner's efforts to squeeze "extra" disclosure from the article through blank assertion or, at best, questionable inference. For example, the Examiner asserts that the NetPlay article discloses the claim elements of "matching contestants within a group subset into subcompetitions (i.e. each age group will be presented with a game according to their ages and knowledge)," and "determining a subcompetition outcome status of each contestant in the subcompetition (i.e. players win points which can be redeemed for prizes)." App. B, at p. 2. But the article does not explicitly disclose either of these elements. Although the disclosed awarding of points, App. C, at p. 1, *could* be based on the outcome of an individual subcompetition, it could also simply

[5] The requirement of a "fixed start time" for "all contestants" was mentioned but never substantively addressed by the Examiner, App. B, at p. 3, even though it is a limitation of claim 1 and therefore all the claims.

reflect a more cumulative or even outcome-independent measure of play.[6] No matter how the article's disclosure is dressed up or supplemented by hindsight-aided "official notice," there is no disguising the fact that, other than its disclosure of a form of activity using a "communication network," it has virtually nothing in common with the claimed invention.

In sum, the NetPlay article – the sole specific reference on which the Examiner has relied – is so substantially different from the claimed invention that it can ultimately serve as no more than a launching pad for speculative beliefs about obviousness. The NetPlay article is an improper basis for a single-reference rejection. *Cf. Grain Processing Corp. v. Am. Maize-Prods. Co.*, 840 F.2d 902, 907 (Fed. Cir. 1988) (rejecting arguments of obviousness where "the 'best' prior art references" "diverge[d] from the patented invention in an important way").

3. The Examiner Improperly Attempts to Use "Official Notice" of a Disputable Proposition – That Increasing the Number of Contestants Makes Competition "More Fierc[e]" – to Provide Motivation for Vastly Increasing the Number of Simultaneous Contestants Allowed by NetPlay.

As noted above, the NetPlay article teaches against the Examiner's only officially noticed motivation for vastly increasing the number of simultaneous contestants. *Supra*, at p. 8. But even if this motivation were compatible with NetPlay's disclosure, the Examiner's use of "official notice" is improper because the proposition noticed – that "includ[ing] a large number of contestants" is "well known" "to make the competition more fierc[e]," App. B, at p. 3 – is disputable and, in fact, ***contradicted by actual facts***. Large numbers of participants do not necessarily entail fierce competition: games like Ultima Online and EverQuest potentially involved large numbers, but centered on role-playing, rather than competition, and lacked means for picking a "unique winner" within a "fixed, short amount of time," Specification, at p. 4, ll. 4-13; *see also* App. D, att. E. Moreover, "includ[ing] a large number of contestants" often dilutes competition – producing lopsided, uninteresting, or chance-determined results, and frequently reducing the excitement of competition itself. Hence, the most "fierce" competitions, and also the most exciting, tend to be those that – like the Olympics, the *Jeopardy!* game show, or (to use the Examiner's example) "world series games" such as Major League Baseball, App. B, at p. 3 – heighten competition by sharply ***limiting*** the number of individuals who may

[6] Similarly, the Examiner relies on inference, rather than explicit disclosure, to conclude that NetPlay's mention of "tournaments" amounts to disclosure of contests having a "unique winner." App. B, at p. 6.

compete. As described by the Specification with specific reference to *Jeopardy!*, competitors commonly cannot gain entry to such skill-based competitions unless they first prove themselves in selective qualifying processes that often take substantial time and resources to complete – *e.g.*, lower-level competition and tests or "trials," or previous play in college or "minor leagues." See Specification, at p. 1, l. 21, to p. 4, l. 2. Indeed, before grouping a select group of eight teams in a playoff tournament that ultimately produces a "world series" champion, Major League Baseball engages participants in various pre-selection processes – permitting only a limited group of players to participate in "spring training," selecting an even smaller group to play in the "big leagues," and finally selecting playoff teams based on the cumulative results of a 162-game regular season.

Thus, contrary to the Examiner's use of official notice, but consistent with two experts' declarations, App. E, at ¶¶ 10-14; App. F, at ¶¶ 9-13, consideration of generally known facts only confirms the revolutionary nature of the invention. Whereas more traditional contests intensify competition by limiting it to an "elite," the invention provides a skill-based competition truly open to all. Hence, an embodiment of the claimed invention – a one-hour trivia contest – has enabled a family caregiver from Springfield, Missouri, to emerge as the "best" from a "large multitude" without requiring her to leave her ailing parents for distant tryouts required by more traditional skill-based competitions. App. D, att. G, at p. 2.

4. Undisputed Facts Contradict the Examiner's Claim That It Is Obvious to Have a "Computer Implemented" Event That Involves Many Simultaneous Contestants But That Nonetheless Ends "In a Short Amount of Time."

The basis for the Examiner's rejections does not improve when the Examiner relies on supposed general knowledge from the computing arts. The Examiner's only explanation for why it is obvious to conduct a contest involving a "large multitude" in a "fixed, short amount of time" is that, "since Netplay is computer implemented[,] therefore the outcome of the winner to be performed in a short amount of time is obvious in order to keep excitement within the game." App. B, at p. 3. Once again, the Examiner improperly takes official notice of a disputable proposition and also assumes the nature of the problem to be solved – "keep[ing] excitement within the game."

Even if it were assumed, however, that the Examiner's determination of the relevant problem is correct and not merely hindsight in disguise, the Examiner is incorrect in asserting

that NetPlay's use of computers means that it is obvious that NetPlay may be used, or modified, to determine a "unique winner" in a short time. NetPlay's website itself advertises that users can "see and chat with other players ... for hours" – suggesting that requiring competition to end in a short time may in fact be undesirable. App. D, att. F, at p. 1. Consistent with this suggestion, "massive multiplayer online games" have typically "not define[d] an end of the game" and have often engaged players for "6-12 months." App. D, att. E. Moreover, even if there were interest in conducting such a massive multi-player game quickly, it might simply be impossible. For example, even if a computer ran a sequentially played game such as poker, and even if the computer gave each player only 10 seconds per card play, a game with 6,000 contestants would require *more than 16 hours* per round of card play. *See* App. D, at p. 5. Clearly, the fact that a game or contest is computer-implemented does not make it obvious that the game or contest can, or even should, be concluded quickly.

Moreover, actual facts contradict the idea that, "to keep excitement within the game," it is obvious that a contest should only last "a short amount of time." Many contests ***build excitement*** by holding competition over an ***extended time***. For example, Major League Baseball builds up to its "World Series" by first engaging players in a months-long regular season and then engaging a select group in playoffs that last for weeks. In sum, general knowledge again serves only to confirm what two sworn declarants have said: the invention's combination of elements is "unique, new and not obvious." App. E, at ¶ 10; App. F, at ¶ 9.

B. Substantial Evidence, Including Two Rule 1.132 Declarations from Experts, Proves That the Invention Is Not Only Nonobvious But, in Fact, Different in Kind from the Prior Art.

There is no *prima facie* case of obviousness. However, even if this were untrue, the claims should be allowed because Appellants have established nonobviousness by at least a preponderance of the evidence. *See In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). All four factors from *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966), support this conclusion.[7]

[7] The four "*Graham* factors" are the following: "(1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of nonobviousness." *McGinley*, 262 F.3d at 1349.

1. Nothing in the Prior Art Is Similar to the Claim 1's Invention, and Information-Systems and Competition Experts Have Recognized That the Invention Is Nonobvious.

Even when attention is focused only on claim 1's core elements, the claimed invention is substantially different from the single reference cited by the Examiner. *Supra*, at pp. 7-9. Indeed, as discussed in the applicants' own specification, nothing in the prior art is substantially similar to the claimed invention. *See, e.g.*, Specification, at p. 5, ll. 8-10. To supplement the Specification's discussion, Appellants submitted to the Examiner a short article on web-based "Massive Multiplayer Online Game[s]" explaining that, unlike the claimed invention, most such games are non-skill-based "RPG (Role-Playing Game) style games" that "do not define an end of the game" and "typically" involve play over a period of "6-12 months." App. D, att. E. Likewise, in a sworn declaration, Professor Ryan Nelson of the University of Virginia, an information-systems expert, has confirmed that the claimed invention is not only novel but also "not obvious," and has explained how the claimed invention is "different in kind" from prior multi-player games. App. E, at ¶¶ 10, 14. Dr. Leszek Pawlowicz, an expert in skill-based games, has also declared that the claimed invention is "not obvious" and, in fact, "fundamentally different" from any prior art of which he was aware, and has supported this conclusion by pointing to "both the time scale of the competition and the number of contestants competing simultaneously." App. F, at ¶¶ 9-10. Along similar lines, the *Wall Street Journal* has reported that "Internet veterans agree" that an embodiment of the claimed invention "add[ed] a new dimension to the Web." App. D, att. G, at pp. 1-2. In sum, evidence relevant to the first three *Graham* factors confirms the claimed invention's nonobviousness.

2. The Invention Has Been Commercially Successful, Has Satisfied a Long-Felt Need in a Novel Way, Has Been Greeted with Acclaim, and Was Developed in the Face of Known Disadvantages to Its Basic Approach.

The fourth *Graham* factor – "secondary considerations" of nonobviousness – reinforces this conclusion. *Cf. In re Rouffet*, 149 F.3d at 1355 (describing various considerations). With respect to commercial success, it is undisputed that the assignee has "received substantial investment primarily as a result of the excitement and novelty" of a contest embodying the invention, and has also "received significant licensing

revenue." App. D, at p. 8. Likewise, even if the Examiner were right in alleging that the invention's combination of elements is a response to long-felt needs (*e.g.*, marketing interests or the desire "to make the competition more fierc[e]," App. B, at pp. 3-4), there was, according to Dr. Pawlowicz, "ample opportunity for others" to develop the invention before Appellants. App. F, at ¶ 12. The fact that nobody did so also favors a conclusion of nonobviousness.

Finally, the Appellants have provided substantial evidence of "acclamations" of the invention. *Cf. Allen Archery, Inc. v. Browning Mfg. Co.*, 819 F.2d 1087, 1092 (Fed. Cir. 1987) (considering praise to be among "the relevant factual criteria"). When an embodiment of the invention was presented to the public in the form of an online, one-hour, million-dollar trivia contest called "Live Trivia," it was viewed as nationally newsworthy and was the subject of reports by *Good Morning America*, CNN, and MSNBC, as well as the Associated Press. App. D, at p. 7. A *Wall Street Journal* article explicitly confirmed that the contest stretched the "***imagin[ation]***" and "***add[ed] a new dimension*** to the Web." App. D, att. G, at pp. 1-2 (emphasis added).

Moreover, articles acclaiming the invention also pointed out positive reasons not to attempt its combination of elements – *i.e.*, technical problems of coordination and communication necessarily entailed in conducting a competition that involves a "large multitude of contestants" in simultaneous, "skill-based" competition that yields a "unique winner" within "a fixed, short amount of time." *Cf. United States v. Adams*, 383 U.S. 39, 52 (1966) ("[K]nown disadvantages in old devices which would naturally discourage the search for new inventions may be taken into account in determining obviousness."). Heath Waldrop's "Technical Knockout" column in an Arizona weekly attested to LiveTrivia's success in overcoming difficulties that led the author to be "shocked" when the embodiment actually worked. App. D, att. H. Similarly, an article by Kurt Wanfried, a reporter specializing in Internet topics, indicated skepticism both as to whether the contest could give him "an equal chance" despite a comparatively slow modem hook-up, and also as to whether the contest could "handle the hammering it takes with all these players connected simultaneously." App. D, att. I. As with Heath Waldrop, the writer's conclusion points unequivocally to the invention's nonobviousness: "***Amazingly***," he said, "everything works great." App. D, att. I (emphasis added).

3. The Examiner's Conclusory Analysis and Improper Use of "Official Notice" Cannot Counterbalance Substantial, Specific Evidence of Nonobviousness.

Such evidence of nonobviousness cannot be outweighed by the Examiner's conclusory analysis and improper use of "official notice" to allege a motivation to combine. If the Examiner were correct in finding that the invention's individual elements were not only previously known but also obvious even when considered ***in combination***, one would expect some suggestion to this effect in a specifically identifiable prior-art reference. But the Examiner has pointed to no such objectively verifiable indication of obviousness and has done nothing to rebut the substantial evidence – including two expert declarations and a host of third-party articles – that the invention was nonobvious. *See In re Rijckaert*, 9 F.3d 1531, 1533 (Fed. Cir. 1993) ("[T]he examiner's assumptions do not constitute the disclosure of prior art.").

C. Except for Claims 9 and 10, Claims 2-16 Recite Unique Combinations of Required Elements That Are Separately Patentable in the Absence of a *Prima Facie* Case of Obviousness. No Such Case Has Been Established With Respect to Any of These Claims.

The Examiner never addressed various limitations specific to dependent claims 2 through 6 and 14. When the Examiner did address elements of dependent claims 2-16, the Examiner's analysis suffered from substantially the same flaws as the Examiner's analysis with respect to claim 1. Hence, even if the Examiner's claim 1 analysis were valid, the Examiner would still have failed to establish a *prima facie* case of obviousness with respect to any of the dependent claims. Moreover, because, except for claims 9 and 10, each of these claims requires a unique combination of elements, the Examiner's failure to establish a *prima facie* case regarding these unique combinations – or to show by a preponderance of the evidence that these combinations are nonobvious – means that these claims are separately patentable and should be presently allowed. *See In re Oetiker*, 977 F.2d at 1445-46.

1. The Examiner Never Addressed Claim 4's "Time Stamping" Limitation.

Claim 4 and thus also claims 5 and 6 require the use of "contestant nodes" to time-stamp subcompetition tasks. App. A, at p. 2. Such use of "time stamping" is a partial solution to the problems of coordination and control inherent in any method that attempts to engage a "large multitude" in simultaneous, skill-based competition. Time stamping overcomes problems of asynchronization (different connection speeds meaning that different contestants receive task information at different times) by, in effect, chronicling that asynchronization and calculating

away its effect. *See* Specification, at p. 23, ll. 18-20. On its face, this solution is more ingenious than obvious, and illustrates the "new types of timing mechanisms ... and methods of tracking participants" that an information-systems expert has said make such a claimed combination "unique," App. E, at ¶ 13. Nonetheless, the Examiner has rejected claims 4-6 without addressing their use of time stamping or even citing a reference that so much as suggests such a practice. Under such circumstances, it is clear that the Examiner cannot have established even a *prima facie* case of obviousness. *See In re Thrift*, 298 F.3d 1357, 1366 (Fed. Cir. 2002).

2. The Examiner Did Not Address Various Other Limitations Added by Dependent Claims 2-3, 5, and 14.

Other limitations in dependent claims are similarly unaddressed by the Examiner and, in the absence of even a *prima facie* case of obviousness, provide separate grounds for patentability. Claim 2's requirement that "subcompetition outcome status" include "at least the states win, lose, and tie," App. A, at p. 1, is counterintuitive to the extent it includes a "tie" state that could frustrate efforts to reduce a "large multitude of contestants" to a "unique winner" in a "fixed, short amount of time." Likewise, the requirement of claims 3 and 5 that "subcompetition tasks" be presented "substantially simultaneously," App. A, at pp. 1-2, creates significant problems of coordination and synchronization at least equal to, and perhaps even greater than, those involved in starting the competition at a fixed time "for all contestants." Finally, although claim 14's use of "click-on electronic coupons" (and not click-through electronic coupons) to provide "user response information," App. A, at p. 4, may seem obvious in hindsight, the Examiner has provided no evidence that this is so. In fact, Appellants have here again developed a neat solution to a real problem – combining information gathering through "coupons" with continuous play in a fast-paced contest. *Cf.* Specification, at p. 26, l. 19, to p. 27, l. 3.

3. Officially Noticed Practices in Spelling Bees Do Not Make Obvious a Massive Multi-Player Contest's Use of a "Server Node" to Enforce a Time Deadline – as Required by Claims 6-16.

Claims 6 through 16 all require that a "server node" enforce a time deadline for contestant responses. App. A, at pp. 2-4. The Examiner has responded by taking "[o]fficial notice" that it is "old and well known in any competition such as [a] spelling-bee and the like to enforce a time deadline for the receipt of the response."[8] App. B, at pp. 3-4. The Examiner makes a generic

[8] The Examiner errs in attributing to claim 4 discussion of the enforcement of time deadlines. *Compare* App. A, at p. 2, *with* App. B, at p. 3.

statement that a "time deadline" allows "equa[l] evaluat[ion]" of contestants "based on the same time frame," but otherwise makes no effort to explain why it was obvious to combine time deadlines of the sort used in a spelling bee – traditionally an event held in a single location with a limited number of participants – with a method using a "server node" to coordinate competition between "a large multitude of contestants" connected only by a "communication network" and thus potentially spread over a wide-ranging geographic space. App. B, at pp. 3-4. In this latter situation, the assumed fact that a time deadline allows for "equa[l] evaluat[ion]" of contestants is improperly noticed: depending on how the deadline is implemented, a time deadline could seriously disadvantage those at greater distances or with slower communication connections. Indeed, given such concerns, it is unsurprising that prior massive multi-player online games typically involved only extended, non-simultaneous play over substantial, even open-ended, periods of time. *See* App. F, at ¶ 10. Given the vast difference between a traditional spelling bee and the claimed invention, conclusory citation of the use of time deadlines in a spelling bee cannot establish the obviousness of using specific technology – a "server node" – to enforce time deadlines in the relevant massive multi-player context. *See In re Oetiker*, 977 F.2d at 1447 ("The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness.").

4. The Examiner's Use of Official Notice Does Not Make Obvious the Invention's Use – as Recited in Claims 8-11 and 13-16 – to Compile Data About Users, to Award Points and Prizes, and to Deliver Branded Questions.

To justify rejecting claims 8-11 and 13-14, the Examiner took "[o]fficial notice" "that it is old and well known in marketing" both "to award click on electronic coupons" and also "to collect information ... to create profile, demographic and psychographic information." App. B, at pp. 4-5. Similarly, to justify rejecting claim 15, the Examiner took "[o]fficial notice" "that it is old and well known for questions to include branded questions as part of a competition in order to test the customers[']' knowledge." App. B, at p. 5. Finally, to justify rejecting claim 16, the Examiner took "[o]fficial notice" that, in retail marketing, "it is old and well known to award points for prizes." App. B, at pp. 5-6. Consequently, and contrary to the requirement that "core factual findings in a determination of patentability" must be based on "concrete evidence in the record," *In re Zurko*, 258 F.3d at 1386, rejection of these claims was based on non-specific,

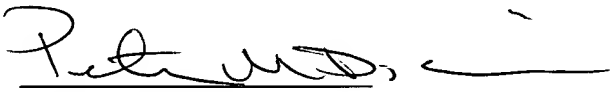
assumed facts that, because of their airy generality, are difficult even to confirm or to deny. Moreover, even if the officially noticed propositions are true, their notice at best establishes that the "noticed" elements existed in isolated form prior to the invention. It does not establish that it was obvious to ***combine*** these elements with the other elements required by claims 8-11 and 13-16. Given that these other claim elements do not indicate a connection to "marketing," no such motivation is obvious on the claims' face, and the Examiner's conclusory reasoning cannot provide the support needed for a determination of obviousness. *See In re Lee*, 277 F.3d at 1343-45.

X. CONCLUSION

Because no *prima facie* case of obviousness has been established, and because the preponderance of evidence shows claims 1-16 to be nonobvious, appellants request that the Board reverse the outstanding rejections under 35 U.S.C. § 103(a), remand the application to the Examiner, and direct the Examiner to issue a Notice of Allowance.

Please deduct the $165.00 fee for filing an appeal brief from our Deposit Account No. 08-0219. No other fees are believed to be due. However, please charge any payments due or credit any overpayments to our Deposit Account No. 08-0219.

Respectfully Submitted,



Peter M. Dichiara
Registration No. 38,005

Dated: 4/13/04

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APPENDIX A

Pending Claims

1. (Amended) A method of using a communication network so that a large multitude of users may simultaneously compete in a skill-based contest as contestants, comprising:

a. identifying a large multitude of contestants;

b. grouping the contestants into group subsets according to group criteria;

c. matching contestants within the group subsets into subcompetitions;

d. for each subcompetition, presenting a competition task over the communication network to the contestants of the subcompetitions;

e. monitoring responses to the competition task from each subcompetition and determining a subcompetition outcome status of each contestant in the subcompetition;

f. grouping at least some of the contestants according to at least one of the group criteria or subcompetition outcome status;

g. repeating acts (c)-(f) until there is a unique winner of the contest wherein the contest begins for all contestants at a fixed start time and converges to the unique winner in a fixed, short amount of time after the fixed start time.

2. The method of claim 1 wherein the subcompetition outcome status includes at least the states win, lose, and tie.

3. The method of claim 1 wherein the subcompetition tasks are presented in act (d) substantially simultaneously.

4. (Amended) The method of claim 1 wherein the competition task is delivered from a server node to contestant electronic nodes and wherein the method further comprises

contestant nodes timestamping the receipt of the competition task, and delivering timing information to a server node in conjunction with contestant responses to the competition task;

the server node analyzing the contestant responses and timing information and determining therefrom competition task successes and elapsed time of successes so that the server node may determine the quickness of contestants independently of the performance of the communication network relative to the contestant nodes.

5. The method of claim 4 wherein the competition tasks are presented substantially simultaneously.

6. The method of claim 5 wherein the server node enforces a time deadline for the receipt of response.

7. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid.

8. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein contestant response information is recorded to create contestant profile information.

9. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein contestant response information is recorded to compile demographic information.

10. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein contestant response information is recorded to compile demographic information.

11. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein contestant response information is recorded to compile psychographic information.

12. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein prizes are awarded to contestants.

13. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server

node to consider the contestant response as valid and wherein prizes are awarded to contestants and wherein the prizes include click-on electronic coupons.

14. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein prizes are awarded to contestants and wherein the prizes include click-on electronic coupons and wherein user activation of a click-on electronic coupon is user response information.

15. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein the competition tasks include branded questions.

16. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein the contests awards points to users based upon their responses, and these points are redeemable for prizes.

APPENDIX B

Office Action of November 18, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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HALE AND DORR
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DOCKET DEPT.
INTELLECTUAL PROPERTY DEPARTMENT

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/536,518	03/22/2000	Jennifer Newnam	109.779.114	2014

7590 11/18/2003

Peter M Dichiara Esq
Hale and Dorr LLP
60 State Street
Boston, MA 02109

EXAMINER	
ALVAREZ, RAQUEL	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

HALE & DORR DOCKETING
RE: 109779.135 US1
Action Date: 2.18.04
Action to be Taken: Due Date.
Docketed By: BMB On: 11.20.03

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)	
	09/536,518	NEWNAM ET AL.	
	Examiner	Art Unit	
	Raquel Alvarez	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 September 2002 and 25 September 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This office action is in response to communication filed on 9/25/2003.

2. Applicant elected invention I (claims 1-16) without traverse.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over article titled, "NetPlay: NetPlay Debuts Internet's Premier Multi-Player Entertainment Network; Netplay Game Club Brings People Together to Create Broad-Bases, Online Community" (hereinafter NetPlay).

With respect to claims 1-3 , NetPlay teaches an electronic network so that multiple users can compete in a skill-based contest (entire document). Identifying a set of contestants (see page 1, 4th paragraph); grouping the set of contestants into group subsets according to group criteria (see page 2, 3rd paragraph); matching contestants within a group subset into subcompetitions (i.e. each age group will be presented with a game according to their ages and knowledge)(page 1, paragraphs 5th and 6th); for each group subcompetition, electronically presenting a competition task (pages 1 and 2); monitoring responses to the competition task from each subcompetition and determining a subcompetition outcome status of each contestant in the subcompetition (i.e. players win points which can be redeemed for prizes)(page 2).

With respect to the contestant being a large multitude. Official notice is taken that it is old and well known to include a large number of contestants in order to make the competition more fiercely. It would have been obvious to a person of ordinary skill in the art a the time of Applicant's invention to have included a large multitude of contestants in order to achieve the above mentioned advantage.

With respect to grouping at least some of the contestants according to the subcompetition outcome status and repeating the monitoring and grouping of the contestants outcome status until there is a unique winner in a fixed, short amount of time after the fixed start time. NetPlay teaches on page 1,4th paragraph that the players can become the ultimate star of the contest by playing in tournaments for additional prizes and since Netplay is computer implemented therefore the outcome of the winner to be performed in a short amount of time is obvious in order to keep excitement within the game. It is also old and well known in world series games, such as baseball and the like to repeat the monitoring of the outcome of the games and then to re-group the winners into a tournament in order to obtain the world championship winner. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included repeating the steps of monitoring and grouping the winners until there is a unique winners because such a modification would allow in the system of NetPlay for players to compete with others winners.

Claims 4, and 12 further recite enforcing a time deadline for the receipt of the response in order to consider the response as valid. Official notice is taken that it old and well known in any competition such as spelling-bee and the like to enforce a time

deadline for the receipt of the response. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included enforcing a time deadline for the receipt of the responses because such a modification would allow to equally evaluate the members based on the same time frame.

The limitations of claim 5 were previously addressed in the rejection to claim 1 addressed above and therefore is rejected under similar rationale.

The limitations of claim 6 were previously addressed in the rejection to claim 4 addressed above and therefore is rejected under similar rationale.

With respect to claims 7, the limitations were previously addressed in the rejections to claims 6 and therefore rejected under similar rationale.

With respect to claims 8-11, in addition to the limitations previously addressed in the rejection to claims 6-7 addressed above, the claims further recite recording responses to create profile information, demographic and psychographic information . Official notice is taken that it is old and well known in marketing to collect information on the costumers in order to create profile, demographic and psychographic information which is often used to target advertisements and products to the customers based on their responses. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included creating profile, demographic and psychographic information with the responses collected from Netplay in order to obtain the above mentioned advantage.

With respect to claims 13-14, in addition to the limitations previously addressed in the rejections to claims 6-7 addressed above, the claims further recite that the prizes include click on electronic coupons. Netplay teaches that members are awarded prizes (page 1). Netplay is silent as to the content of the prizes. Official notice is taken that it is old and well known in marketing to award click on electronic coupons to computers users to induce purchasing. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the prizes of Netplay to include click-on coupons in order to obtain the above mentioned advantage.

With respect to claim 15, in addition to the limitations previously addressed in the rejections to claims 6-7 addressed above, the claims further recite that the competition tasks include branded questions. Official notice is taken that it is old and well known for questions to include branded questions as part of a competition in order to test the customers knowledge on the subject. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included that the competition tasks include branded questions in order to obtain the above mentioned advantage.

With respect to claim 16, in addition to the limitations previously addressed in the rejections to claims 6-7 addressed above, the claims further recite awarding points that are redeemable for prizes. Official notice is taken that it is old and well known to award points for prizes. For example, certain retailers will award points for purchase which can be redeemed for prizes to motivate the customers to make purchases within the

establishment. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included awarding points that can be redeemable for prizes in order to obtain the above mentioned advantage.

Response to Arguments

4. The Examiner is making this action non-final because some of the claims were not previously addressed.

The examiner disagrees with Applicant that Netplay does not teach selecting an unique winner. The Examiner asserts that Netplay teaches a tournament in which players are eligible for prizes. A tournament in itself is a competition which produces a winner.

The Applicant argues that Netplay doesn't teach a large multitude of players. The Examiner asserts that changing the size is obvious. See *In re Rose*, 105 USPQ 237, 240; 220 F2d 459 (CCPA 1955)

The examiner reviewed the declaration and the articles presented by the Applicant. The Examiner wants to point out that the claims were not and are not rejected under 102. The claims were instead rejected under 103 and the modifications to the claims were considered to be within the level of ordinary skill in the art.

Point of contact

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

Raquel Alvarez
Examiner
Art Unit 3622

R.A.
11/12/03

APPENDIX C

NetPlay Article

"NetPlay: NetPlay Debuts Internet's Premier Multi-Player Entertainment Network; NetPlay Game Club Brings People Together To Create Broad-Based, Online Community"

0677100/9
DIALOG(R)File 810:Business Wire
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0677100 BW1006

NETPLAY: NetPlay Debuts Internet's Premier Multi-Player Entertainment Network; NetPlay Game Club Brings People Together To Create Broad-Based, Online Community

March 03, 1997

Byline: Business Editors/Computer & Entertainment Writers
Dateline: SAN DIEGO
Time: 03:03 PT
Word Count: 610

I

SAN DIEGO--(BUSINESS WIRE)--March 3, 1997--NetPlay, Inc., an entertainment technology and software developer, today announced the official unveiling of its NetPlay Game Club, an online, multi-player entertainment community designed to attract people of all ages and skill levels, including families.

II

Previously in beta test, the full-blown NetPlay service will debut on April 1. The Game Club will offer both free and premium levels of membership, as well as the opportunity to win points and redeem them for prizes in the Club's Prize Center.

III

The NetPlay Game Club, located at www.netplay.com, consists of an assortment of stimulating games, ranging from trivia to traditional card games, for people ready to move beyond the "blood and guts" mentality found in many online gaming networks. The network also includes a wide range of chat capabilities that enable members to socialize while they're online.

IV

Anyone can join the NetPlay Game Club for free as a "Guest" member and receive 3 hours of playing time per month, plus the opportunity to win points as they play. Guests can become "Star" members for only $19.99, which includes six months of unlimited playing time, eligibility to play in tournaments for more prizes, the ability to select players for private games, and full technical support from NetPlay.

V

"The NetPlay Game Club is an entertainment center that will appeal to people of all ages," said Leland Ancier, NetPlay chief executive and technology officer. "The Club offers a variety of compelling games that will attract the mainstream home computer user who isn't interested in violence."

VI

Club members can play a number of different, easy-to-learn games, including classic games like Poker and Crazy 8s, as well as fast-paced, fun games like Hot Potato. They can also put their knowledge of everyday facts to the test while playing Trivia, the Club's game show style face-off. Because the Club has the appearance of a real-life game room, members will feel close to the action while in the heat of friendly battle. The NetPlay Game Club also provides live "Angels," who are waiting in the wings to participate in games and assist members, as well as promote good behavior.

VII

The Game Club's advanced chat capabilities enable members to meet new people and strike up virtual conversations via written text and sound, using drag and drop messaging. Every game comes with an intuitive interface and chat function that lets members socialize while they're playing. After a friendly competition, members can enter into different chat areas, each with its own unique theme, such as a campfire, the beach, and the moon.

NetPlay does not require use of a browser or plug-ins, so hard-disk speeds are achieved during game play. What's more, the Game Club's automated updating technology ensures that every member is playing on the most recent version of each game, and that new games can be automatically downloaded.

NetPlay, Inc. is a privately-held technology and software development company based in San Diego, CA. The company's signature product is the NetPlay Game Club, an online, multi-player entertainment community designed to attract people of all ages and skill levels, including families. The Game Center features free and premium memberships, as well as the opportunity to win points and redeem them for prizes. The company also developed the patent-pending AdRunner technology, for its Game Club and licensing, that delivers advertising and direct-response offers on a guaranteed target audience basis. Game play requires a computer with a Pentium processor; Windows 95 or NT platform; at least a 14.4 bps modem; and Internet access.

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Pamela Coddington or David Friel, 415/217-7500
pamela@connors.com
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or
NetPlay Inc.
Jeff Herscovitz, 619/350-1240 ext. 106
KEYWORD: CALIFORNIA
INDUSTRY KEYWORD: COMPUTERS/ELECTRONICS COMED INTERACTIVE/MULTIMEDIA/INTERNET ENTERTAINMENT PRODUCT

APPENDIX D

Reply of March 25, 2003, With Attachments A-K

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Jennifer Newnam et al

Serial No. 09/536,518

Examiner: R. Alvarez
Group Art Unit: 3622

Filed: March 22, 2000

Title: A Method and System of Playing and Controlling a Contest for a Large Number of Simultaneous Contestants

Commissioner for Patents
Washington, D.C. 20231

Reply

Dear Sir:

In response to the Office Action of September 27, 2002, please make and consider the following amendments:

In the Specification,

Please substitute original page 4 with new page 4, which removes the hyperlinks objected to in the Office Action. A marked-up version of page 4 is provided as Attachment A, and a clean version is provided as Attachment B.

In the Claims

A marked-up version of the amended claims is provided as Attachment C. A clean version is provided as Attachment D.

Remarks

Reconsideration of this application, as amended, is respectfully requested. Claims 1-18 remain in the case. Claims 1, 4, and 7-18 are amended. No claims are canceled or added.

Objections and Informalities

The claims were amended to more clearly recite subject matter in the technological and useful arts. Specifically, the bodies of the claims now more clearly include recitation of the use of a "communications network." Consequently, no basis exists to reject the claims under §101.

The specification was amended to address the objections concerning hyperlinks within the specification.

Claim 1 is amended to address the §112 rejection in the Office Action.

Art Rejections

Initial Matters

As an initial matter and for the sake of a clear record, not all of the claims that should have been analyzed were, and for some of the claims that were considered, not all of their limitations were properly analyzed. Consequently, applicants should not receive a Final Rejection in response to this Reply, as some original claims have not yet been examined.

For example, the Office Action provides no analysis of original independent claim 4 even though it had materially different claim limitations and scope than claim 1. Original claim 4 recites aspects directed to time stamping the receipt of competition tasks and the analysis of timing information. The Office Action is devoid of any analysis of these features and it is unclear why claim 4 (and its dependents 5-6) was rejected.

Likewise, the Office Action provided no analysis for independent claims 17 and 18, even though they had materially different claim limitations and scope than claim 1. Claim 17 for example is directed to a skilled based competition in which contestant responses are analyzed to create a specific user profile. Claim 18 is directed to a scoring technique in which a signature indicates the contestants' responses. The Office Action is devoid of any analysis of these features and it is entirely unclear why these claims were rejected.

Moreover, (previously) multiply dependent claims 8-16 were erroneously not considered on the merits. The original claims (erroneously) used the conjunctive "and" instead of the disjunctive "or." However, this form of claiming error is minor, and MPEP §608.01(n) makes clear that claims having such specific form of error be considered (contrary to the position stated in the Office Action). MPEP §608.01(n), in fact, only allows multiple dependent claims to be not considered on the merits when (a) they depend from another multiple dependent claim (see MPEP 600-71) or (b) they "cannot be understood" (see MPEP 600-73). In fact, the MPEP states that the claims should be considered on the merits and "no objection as to form need be made" when the dependency is clear. Id.

Substance of Rejection and Arguments in Response

Original claims 1-7 were rejected as unpatentable in view of an article about NetPlay and in view of the World Series. In short, the Office Action asserted that the NetPlay article taught most of the recited aspects of original claim 1 and that the World Series taught the regrouping of winners in a tournament to obtain an ultimate winner.

The Office Action asserted without support that it would have been obvious to modify NetPlay's teachings to include the repeated monitoring of winners until there is a unique winner. Moreover, several of the assertions in the Office Action were incorrect. For example, the Office Action's stated that the NetPlay article discloses a unique winner through disclosure of an "ultimate star" (see Office Action at p.4). This statement is incorrect. The NetPlay article never makes reference to an "ultimate star" and instead makes reference to a "star member." More importantly, the NetPlay article is explicit that a "star member" is a service level one may purchase for $19.99, not a unique winner status.

Moreover, the Office Action suffers a fundamental flaw of hindsight analysis. Specifically, the Office Action refers to no evidentiary support for the purported modifications,

and as outlined in more detail below provides no showing of even a suggestion (let alone a teaching) for the type of contest recited in the claims.

Amended claim 1 recites a method that allows a communication network to be used so that a large multitude of contestants may compete, resulting in a unique winner in a fixed, relatively short amount of time. (Support for the limitations that are directed to the large multitude of contestants and simultaneous play is found in the title of the application itself and at pages 7-9, 17, and 20 of the specification. Support for the limitations directed to the start and end times is found at pages 4, 7-8, and 10.)

As explained throughout the specification (indeed it's in the title of the application), the method concerns a skilled-based contest for a large multitude of simultaneous contestants in a given, single skill-based contest. The specification, for example, explains that exemplary methods allow on the order of millions of contestants to compete in a given, single contest and, at other points, states that the method allows "massive amounts of participants" (see page 17). (Of course, the actual number of contestants who actually compete in real life depends on the contestants themselves.) The phrase "large multitude" on its own, and also in view of the specification, has clear meaning in the relevant art and generally refers to games having an extraordinary number of contestants. For example, today, people in the art use the term Massive Multiplayer Online Game (MMOG) to refer to games having a huge number of players (see attached sheet E, entitled "What are Massive Multiplayer Online Games?" from website www.zona.net.) (Applicants do not know whether any of the games mentioned in the article properly constitute prior art but nonetheless distinguish such known MMOGs below.)

In contrast, the Office Action cites no games involving a large multitude of simultaneous contestants, and provides no art suggesting such. The NetPlay article refers to internet-based

versions of games such as Poker and Crazy 8s, which are each known to have relatively few contestants per contest. Likewise the World Series involves very few teams.

Indeed, Applicants provide herewith Attachment F which is a more recent description of the NetPlay game, cited in the Office Action.

Encircled in red in the upper right corner of page 1 is a statement "Play these games with op to six people!" This statement clearly shows an upper limited of six contestants and moreover the use of an exclamation mark indicates emphasis for such an upper limit. Clearly an upper limit of six people is a far cry from the present invention.

The Office Action cites no teaching or suggestion as to how the cited art might be modified to allow a large multitude of users, and provides no support for the proposition that having such games modified for a large multitude of users would be desirable or obvious. Indeed the facts are opposite. For example, a sequentially played game (such as poker) would require in excess of 16 hours per card play with 6,000 contestants each having 10 seconds per card play. In addition, a large multitude of players clearly could not be supported by a single deck of cards, and combining decks of cards would introduce statistical probabilities of illegal card combinations and the like.

Moreover, amended claim 1 recites a method that supports a skilled-based contest in which a large multitude of contestants begin at a fixed start time and the game converges to a unique winner a short time thereafter. The specification for example explains that exemplary games end in about an hour, even if supporting about a million contestants. As explained in the specification, such a format helps create the excitement for players, advertisers and sponsors.

In contrast, the Office Action cites no games supporting a large multitude of users and having fixed start times and ending shortly thereafter. Indeed as explained above, sequentially

played games have end times that are linearly related to the number of contestants and thus will have enormous play times if enormous numbers of contestants are involved.

Moreover, known MMOGs such as EverQuest do not change the situation. These games are not real skill-based contests, but instead are role-playing games (see attached sheet E, entitled "What are Massive Multiplayer Online Games?" from website www.zona.net.). They do not have fixed start times and do not end with a unique winner in a reasonably short time. Instead, players come and go as they please (meaning they are not truly simultaneous) in simulations that last weeks or months. Id. They are akin to the interactions described in the Background section of the specification at page 4.

Objective evidence shows that the recited game has consistently been treated as inventive, novel and not obvious, and applicants are aware of no evidence to the contrary. Moreover, applicants have provided herewith two Rule 132 declarations supporting such views from independent experts, each offering a unique perspective (one from a game expert, and another from an Internet expert).

For example, Attachments G-H are unsolicited statements from the media describing the *Live Trivia* game that embodied the invention. It should go without saying that the News media tries to devote attention to novel, newsworthy events. They do not try to report on old or obvious events.

Attachment G is a Wall Street Journal (WSJ) article devoted to *Live Trivia* game that embodied the invention. It was published soon after the game began to be played publicly. (See "Internet Quiz Show Intends to Transform Interactive TV, by William Bulkeley, WSJ.com, June 26, 2000, attached.) The article was written by William Buckeley who is a WSJ staff writer who has written about innovations on the Internet and contributes to WSJ's technology column,

"Digits. Gambits & Gadgets in the World of Technology." After referring to the then-popular TV show "Who Wants to Be a Millionaire", the Bulkeley article stated: "Now, imagine the same game with 20,000 contestants." (Emphasis added.) The Bulkeley article's word choice – specifically that the readers would need to imagine -- clearly shows that the news media considered the game to be truly unique.

Likewise, Attachment H is an article by Heath Waldrop for his column "Technical Knockout" and it's about the *Live Trivia* game that embodied the invention. He states, in connection with describing the game, that the interactivity was fun "and a novel idea."

In addition, the company was featured on *Good Morning America, CNN, and MSNBC* in connection with the *Live Trivia* game that embodied the invention. The Associated Press reported on the game and it was picked up in newspapers around the country. Many other articles reported on the game (see, e.g., Attachments I-K).

All these unsolicited testimonials indicate that the game is novel and unique (this goes to the heart of being newsworthy, especially on this scale).

Attached herewith is a Declaration from Dr. Leszek Pawlowicz. As the declaration shows, Dr. Pawlowicz is an extremely well known game show contestant and has been analogized to be the "Michael Jordan" of game shows. In this regard, he is an expert at skill-based contests, and in his opinion the game and the invention are novel and non-obvious. As he describes, the invention's support of an enormous number of simultaneous contestants in real time was unique and not obvious.

In addition, attached herewith is a Declaration from Dr. Ryan Nelson. Dr. Nelson is a Professor at the University of Virginia and is an expert on information systems, such as the Internet. He too refers to the invention's ability to support a large volume of simulatanous

contestants as unique. Dr. Nelson is not being compensated for his time in connection with the Declaration.

Neither Dr. Pawlowicz or Dr. Nelson is aware of any art before the filing date of this application that suggests the invention is not novel or not obvious.

Moreover, the assignee received substantial investment primarily as a result of the excitement and novelty of the game, and has received significant licensing revenue to date as well. Consequently, the invention as recited in amended claim 1 should be found allowable. There is a vast body of objective evidence supporting this view and no known evidence to the contrary. Indeed, even the art relied on by the Patent Office suggests the contrary (see, e.g., Attachment F's reference to an upper limit of only 6).

Amended claim 4 recites another novel and non-obvious aspect of allowing a skill-based competition among a large multitude of contestants. More specifically, contestant nodes time stamp the receipt of a competition task and deliver timing information to a server node in conjunction with contestant responses. The server node analyzes the responses and the timing information to determine success and elapsed time such that the contestants' quickness may be determined independently of the relative performance of the network. Some of the attachments refer to this aspect, again, with laudatory terms. (Support for the changes to claim 4 is found at the same pages as outlined above with regard to the large multitude of contestants and at pages 23-5 for the timing limitations.)

As explained in the specification, the recited aspects allows the game to be played more fairly, by reducing the possibility of a contestant getting a technical advantage from a faster modem or link. Indeed, the initial public play of the game was won by a contestant using a relatively slow modem.

As outlined above, this claim was not analyzed in the Office Action. However, it is clear that none of the cited or known art even hints at the recited features.

Amended claims 8-16 recite several novel and non-obvious features, related to the creation and use of various forms of contestant profiles, click-on coupons, and branded questions. These claims were amended to correct informalities and to recast them as dependent on claim 1. The subject matter should have been, but was not, considered in the Office Action. The recited features are not taught or suggested by the cited art.

Amended claim 17 is directed to a skill-based contest for a large multitude of users and in which profile information about user preference, interests, or contestant competition task performance is created by analysis of contestant responses. The subject matter should have been, but was not, considered in the Office Action. The recited features are not taught or suggested by the cited art.

Amended claim 18 is directed to a skill-based contest for a large multitude of users and in which a unique signature for each contestant is created that is indicative of at least some of the contestant's responses to competition tasks. The subject matter should have been, but was not, considered in the Office Action. The recited features are not taught or suggested by the cited art.

In view of the arguments set forth above, Applicant respectfully submits that the rejections contained in the final Office Action, have been overcome, and that the claims are in condition for allowance. If the Examiner believes that any further discussion of this communication would be helpful, please contact the undersigned at the telephone number provided below.

Applicant encloses herewith a Petition for a Three Month Extension of Time pursuant to 37 C.F.R. § 1.136, to respond to the Examiner's Office Action. Our deposit account no. 08-0219 is to be charged the $465.00 fee for this purpose.

Applicant also encloses herewith a Notice of Appeal. Please charge Deposit Account No. 08-0219 the $160.00 fee for this submission.

Please charge any underpayments or credit any overpayments to Deposit Account No. 08-0219.

Respectfully submitted,

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March 25, 2003
Attorney Docket No.: 109779.135

two inefficiencies combined relegate the average person to participating vicariously by watching taped versions of games played days in advance.

In addition to traditional game shows, multi-player video-based games exist. Multi-player video-based games such as UltimalOnline ~~(www.UltimalOnline.com)~~ allow multiple people to engage in an electronic game at one time. This provides additional value to consumers who would like to participate in a game with multiple people. Additionally, becoming a participant in the game takes little time since it can be accessed from a connection to the Internet. However, participants must pay to play the game. Further, these games do not satisfy the general requirements of competitive skill-based games such as game shows which have (1) a winner and (2) a defined start and end time. These games are ongoing interactions that allow participants to take turns in order to simulate interactions though they are not actually playing simultaneously.

A number of games have arisen on the Internet that simulate game shows broadcast over television. For instance, Sony has a number of games that can be played over the Internet which simulate traditional game shows. Jeopardy! Online or Trivial Pursuit Online ~~(www.station.sony.com)~~ are Internet games that allow multiple players to come together to simulate the traditional versions of these games. This allows individuals who would like to feel the competitive nature of these games to enjoy them online. However, four key elements are missing from the value proposition: (1) the games simply pool a limited number of individuals into a simulated game as the players arrive at the site and (thus, one cannot really compete against the larger public), (2) the

two inefficiencies combined relegate the average person to participating vicariously by watching taped versions of games played days in advance.

In addition to traditional game shows, multi-player video-based games exist. Multi-player video-based games such as UltimalOnline allow multiple people to engage in an electronic game at one time. This provides additional value to consumers who would like to participate in a game with multiple people. Additionally, becoming a participant in the game takes little time since it can be accessed from a connection to the Internet. However, participants must pay to play the game. Further, these games do not satisfy the general requirements of competitive skill-based games such as game shows which have (1) a winner and (2) a defined start and end time. These games are ongoing interactions that allow participants to take turns in order to simulate interactions though they are not actually playing simultaneously.

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Attachment C (Marked-Up Version)

Please amend the claims as follows. For the Examiner's convenience, all pending claims are shown below in marked-up form. Unamended claims are shown in small font.

1. (Amended) A method of using [an electronic] a communication network so that [multiple] a large multitude of users may simultaneously [can] compete in a skill-based contest as contestants, comprising:

a. identifying [a set] a large multitude of contestants;

b. grouping the [set of] contestants into group subsets according to group criteria;

c. matching contestants within the [a] group subsets into subcompetitions;

d. for each subcompetition, [electronically] presenting a competition task over the communication network to the contestants of the subcompetitions;

e. monitoring responses to the competition task from each subcompetition and determining a subcompetition outcome status of each contestant in the subcompetition;

f. grouping at least some of the contestants according to at least one of the group criteria or subcompetition outcome status;

g. repeating acts (c)-(f) until there is a unique winner of the contest wherein the contest begins for all contestants at a fixed start time and converges to the unique winner in a fixed, short amount of time after the fixed start time.

2. The method of claim 1 wherein the subcompetition outcome status includes at least the states win, lose, and tie.

3. The method of claim 1 wherein the subcompetition tasks are presented in act (d) substantially simultaneously.

4. (Amended) [A method of using an electronic network so that multiple users can compete in a skill-based contest comprising:

a. identifying a set of contestants distributed over the electronic network;

b. electronically delivering a competition task to contestant electronic nodes;]

The method of claim 1 wherein the competition task is delivered from a server node to contestant electronic nodes and wherein the method further comprises

[c.] contestant [electronic] nodes timestamping the receipt of the competition task, and delivering timing information to a server node in conjunction with contestant responses to the competition task;

[d.] the server node analyzing the contestant responses and timing information and determining therefrom competition task successes and elapsed time of successes so that the server node may determine the quickness of contestants independently of the performance of the communication network relative to the contestant nodes.

5. The method of claim 4 wherein the competition tasks are presented substantially simultaneously.

6. The method of claim 5 wherein the server node enforces a time deadline for the receipt of response.

7. (Amended) [A method of using an electronic network so that multiple users can compete in a skill-based contest, comprising:

a. identifying a set of contestants distributed over the electronic network;

b. multicast delivering a competition task to contestant electronic nodes substantially simultaneously, so that each contestant competes simultaneously with other contestants;

c.] The method of claim 1 wherein contestants [responding] respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid.

8. (Amended) The [methods] method of [claims] claim 1[, 4, and 7] wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein contestant response information is recorded to create contestant profile information.

9. (Amended) The [methods] method of [claims] claim 1[, 4, and 7] wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein contestant response information is recorded to compile demographic information.

10. (Amended) The [methods] method of [claims] claim 1[, 4, and 7] wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein contestant response information is recorded to compile demographic information.

11. (Amended) The [methods] method of [claims] claim 1[, 4, and 7] wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein contestant response information is recorded to compile psychographic information.

12. (Amended) The [methods] method of [claims] claim 1[, 4, and 7] wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein prizes are awarded to contestants.

13. (Amended) [The methods of claim 12] The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein prizes are awarded to contestants and wherein the prizes include click-on electronic coupons.

14. (Amended) [The method of claim 13] The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant

response as valid and wherein prizes are awarded to contestants and wherein the prizes include click-on electronic coupons and wherein user activation of a click-on electronic [coupons] coupon is user response information.

15. (Amended) The [methods] method of [claims] claim 1[, 4, and 7] wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein the competition tasks include branded questions.

16. (Amended) The [methods] method of [claims] claim 1[, 4, and 7] wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein the contests awards points to users based upon their responses, and these points are redeemable for prizes.

17. (Amended) A method of using [an electronic] a communication network so that [multiple] a large multitude of users may simultaneously [can] compete in a skill-based contest as contestants, comprising:

a. presenting competition tasks to contestants;

b. collecting responses to the competition tasks from the contestants;

c. analyze the responses to create user profile information about user preference, interests, or contestant competition task performance.

18. (Amended) A method of using [an electronic] a communication network so that [multiple] a large multitude of users may simultaneously [can] compete in a skill-based contest as contestants, comprising:

a. presenting competition tasks to contestants;

b. analyzing contestant responses;

c. creating a unique signature for each contestant indicative of at least some of the contestant's response.

Attachment D (Clean)

For the Examiner's convenience, all pending claims are shown below in marked-up form. Unamended claims are shown in small font.

1. (Amended) A method of using a communication network so that a large multitude of users may simultaneously compete in a skill-based contest as contestants, comprising:

a. identifying a large multitude of contestants;

b. grouping the contestants into group subsets according to group criteria;

c. matching contestants within the group subsets into subcompetitions;

d. for each subcompetition, presenting a competition task over the communication network to the contestants of the subcompetitions;

e. monitoring responses to the competition task from each subcompetition and determining a subcompetition outcome status of each contestant in the subcompetition;

f. grouping at least some of the contestants according to at least one of the group criteria or subcompetition outcome status;

g. repeating acts (c)-(f) until there is a unique winner of the contest wherein the contest begins for all contestants at a fixed start time and converges to the unique winner in a fixed, short amount of time after the fixed start time.

2. The method of claim 1 wherein the subcompetition outcome status includes at least the states win, lose, and tie.

3. The method of claim 1 wherein the subcompetition tasks are presented in act (d) substantially simultaneously.

4. (Amended) The method of claim 1 wherein the competition task is delivered from a server node to contestant electronic nodes and wherein the method further comprises

contestant nodes timestamping the receipt of the competition task, and delivering timing information to a server node in conjunction with contestant responses to the competition task;

the server node analyzing the contestant responses and timing information and determining therefrom competition task successes and elapsed time of successes so that the server node may determine the quickness of contestants independently of the performance of the communication network relative to the contestant nodes.

5. The method of claim 4 wherein the competition tasks are presented substantially simultaneously.

6. The method of claim 5 wherein the server node enforces a time deadline for the receipt of response.

7. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid.

8. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein contestant response information is recorded to create contestant profile information.

9. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein contestant response information is recorded to compile demographic information.

10. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein contestant response information is recorded to compile demographic information.

11. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein contestant response information is recorded to compile psychographic information.

12. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein prizes are awarded to contestants.

13. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein prizes are awarded to contestants and wherein the prizes include click-on electronic coupons.

14. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein prizes are awarded to contestants and wherein the prizes include click-on electronic coupons and wherein user activation of a click-on electronic coupon is user response information.

15. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein the competition tasks include branded questions.

16. (Amended) The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein the contests awards points to users based upon their responses, and these points are redeemable for prizes.

17. (Amended) A method of using a communication network so that a large multitude of users may simultaneously compete in a skill-based contest as contestants, comprising:

a. presenting competition tasks to contestants;

b. collecting responses to the competition tasks from the contestants;

c. analyze the responses to create user profile information about user preference, interests, or contestant competition task performance.

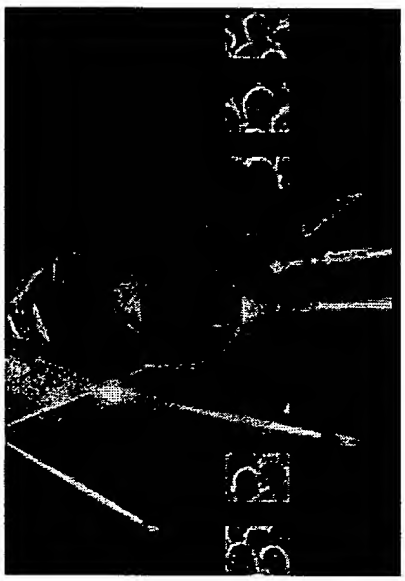
18. (Amended) A method of using a communication network so that a large multitude of users may simultaneously compete in a skill-based contest as contestants, comprising:

a. presenting competition tasks to contestants;

b. analyzing contestant responses;

c. creating a unique signature for each contestant indicative of at least some of the contestant's response.

What is an MMOG?



MMOG in an acronym that stands for Massive Multiplayer Online Game. This is the kind of online game that allows a huge number of players (greater than 1,000) to play in the same game concurrently.

Unlike small online games such as Quake or UnReal Tournament, MMOGs are hosted by publishers and/or data centers around the clock. This makes these games costly and time consuming to develop.

The first MMOGs were Ultima Online, EverQuest, CrossGate, and so on. Most of these MMOGs are RPG (Role-Playing Game) style games and do not define an end of game. Rather the players are involved in a continuing story more akin to the real world. These games allow players to develop their own game style, so that players can stay in the game for a long time, typically 6-12 months. Also, the players will be interacting with other players all over the world.

"Games were never more fun than with NetPlay, a new multi-player game network." - California Computer News

Now you never have to play games alone!


Join Now!

It's hard to get friends together to play in person. But in the NetPlay Game Club, you always have a clique of friends just a click away who will happily play Trivia Challenge, Poker Party, Crazy 8s, or Hot Potato anytime your want! The NetPlay Game Club is the first Internet game network that lets you see and chat with other players over the Internet - in real time - for hours of highly social, family-safe fun!


Join Now!

Read what  ***Joyce has to say.***

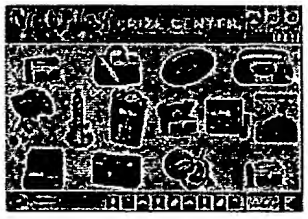
Whoa! It's like you're all in the same room!

Unlike other Internet multi-player games, NetPlay gives you the true feeling that you're playing with real people - because you are! You can see a picture of the other players sitting across from you. You can chat along with others while you play, with the notes appearing in a bubble over the speaker's picture. You can also cheer and jeer your opponents by clicking on dozens of fun pre-recorded sounds and goofy lines. You can chat even if you choose not to play. Plus, you can send game invitations to other members on-line.

Read what  ***Shirley has to say.***

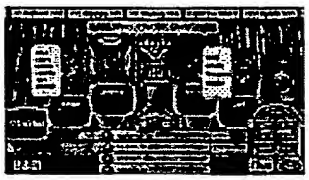

Join Now!

Earn points and win fabulous prizes!



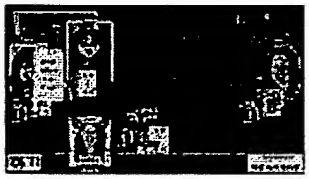
Every time you play, you earn points based on your score. Collect enough and you can exchange points immediately for terrific merchandise in the NetPlay Prize Center.

Choose from a wide selection of toys, music CDs, videos, sweatshirts, software, home electronics and other prizes valued at $1 to $1000 and up!



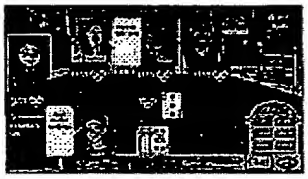
Trivia Challenge

Play this exciting trivia game with questions for every playing audience. Categories vary from children-oriented subjects to the graduate level. This way the whole family can have fun.



Poker Party

Come on over and join the party. It's Poker time and the game is 7 Card Stud. Bet, play, and win. At the end of the party, we will see who has the most chips.



Crazy 8s

The easy-to-play card game for children. You must match the suit or face value of the card on the pile to discard from your hand. Look for those crazy 8 wild cards!

Join Now!

Read what  ***Paul has to say.***

An Internet funhouse that parents can feel good about!

All NetPlay games are family-oriented. The best part is that parents don't have to worry about their kids once they're on-line. Parents can restrict who their children play with by age. NetPlay also features live "Angels" who promote positive interaction, respond to complaints, and, along with NetPlay's filtering software, help ensure that harsh, offensive language is not used. And personal information about members is kept confidential.

Read what  ***Matt has to say.***

Join Now!

NetPlay technology makes games faster and more fun!

Since the game software resides on your hard drive, the games operate fast, without typical Internet delays. Automatic player matching frees members from having to find their own partners. Plus, you get free automatic updates! Every time you log on to NetPlay, it automatically downloads the very latest version of the software and any new games as they become available!

Join Now!

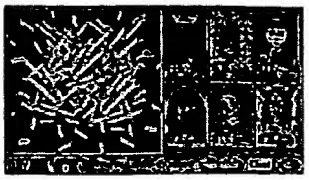
Read what  ***SJP has to say.***

Chat like you've never chatted before!

For even more chatting fun, slip into to one of our separate theme-based chat areas. Chat down on the beach or up on the moon. Tell ghost stories by the campfire. Talk business in the boardroom. And more! Create your own topics and invite other members. You can even send private messages and drop in assorted sound effects, too.

Read what  ***Ginger has to say.***

Join Now!

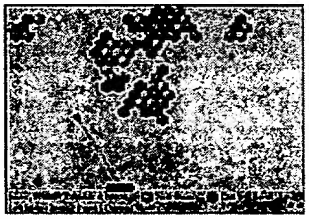


Hot Potato

A very fast action potato passing game. Drop it on your friend and watch out. It gets faster and hotter and you may not be able to keep up.

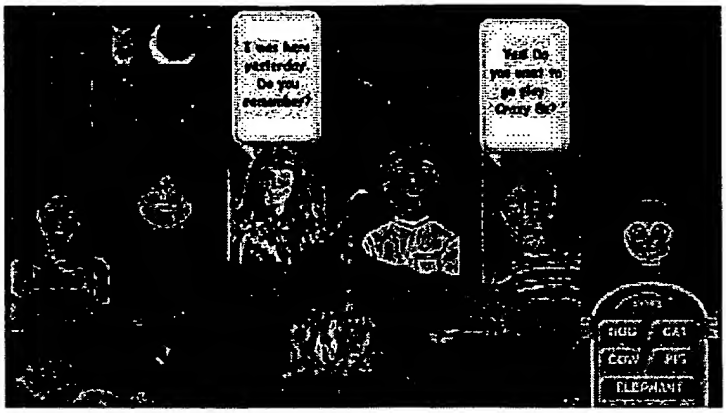
Patience

Here's a traditional solitaire card game you can play on your own to pass the time or while waiting to play another game with friends. Trying to build the four suits in ranking order can be a surprisingly addictive challenge.



HexaGone

Entertain yourself with this fast-paced arcade game for one player. Earn points by bouncing your laser ball off of your paddle to knock out as many HexaTiles as possible before they grow. It's a great way to let off stream!


I was here yesterday. Do you remember?
Yes! Do you want to go play Crazy 8s?
HORSE
CAT
COW
PIG
ELEPHANT

Q: Who Wants to Be the Web's Next Zillionaire? A: GoldPocket.com

Start-Up Hoping to Transform Interactive TV Bides Time As an Internet Trivia Quiz

By WILLIAM M. BULKELEY
Staff Reporter of THE WALL STREET JOURNAL

Regis, schmegis.

On "Who Wants to Be a Millionaire," the ABC network's popular game show, one person plays against the house for a $1 million prize. Now, imagine the same game with 20,000 contestants.

E-BUSINESS

A weekly report

PAGE B6

That, in a nutshell, is GoldPocket.com—the hottest quiz game on the Internet. Every Sunday night, the trivia contest pits players across the country in a series of head-to-head duels. Winners advance to the next round, and at the end of an hour, one surviving player remains, guaranteed to win at least $250,000 and as much as $1 million.

A pair of newly minted M.B.A.'s from Harvard Business School started the weekly contests May 25, as a publicity stunt for their company, GoldPocket Interactive Inc. The point is to showcase their real product—a nationwide synchronized network of high-speed computers that allow up to two million people simultaneously to bid in an auction, vote in a poll, participate in a class—or play a trivia game.

Not counting last night's contest, GoldPocket has given away prizes with a total face value of $4 million—and has yet to land a paying client. Scott Newnam, the Medford, Mass., company's 27-year-old chairman, chief executive and co-founder, says he expects to have some "large events" involving TV on board soon.

Even in the dot-com world, where million-dollar spots on the Super Bowl and $100,000 coming-out parties are standard for start-ups, giving away up to $1 million a week seems a bit generous. Mr. Newnam says expenses aren't as high as some people might imagine.

For one thing, unlike the cash prizes on "Who Wants to be a Millionaire," GoldPocket's prizes take the form of 25-year annuities. As a result, the $4 million in prizes awarded has actually cost the company only $2 million. At an expected cost of $260,000 a week in prizes, Mr. Newnam notes, "We could keep going for a long time."

Mr. Newnam declines to disclose costs of building the GoldPocket network but says suppliers are eager to work with it. On Friday, GoldPocket sent an invoice to the quiz show's first advertising sponsor. Sponsorship revenues are expected eventually to cover its costs. "We're designed to actually make money," Mr. Newnam says.

Indeed, the operation is downright frugal, Mr. Newnam says. Until last week, GoldPocket's 30 employees worked in a 1,700-square-foot building behind an auto-body shop a few minutes away from the business-school campus. Earlier this month, they were called in to pack computers, furniture, files and cases of caffeinated soft drinks into a big Ryder truck and move them to a larger office a few miles away.

Since January, GoldPocket has raised $51.7 million from investors including RRE Ventures, a venture-capital fund headed by former American Express Co. CEO James Robinson III; Thomas H. Lee Co., the Boston investment firm; and Allen & Co., the Wall Street entertainment-industry financier. Except for spending a portion of its $15 million advertising war chest, Mr. Newnam says GoldPocket still has most of the money.

GoldPocket insiders envision selling time on the computer network to auctioneers or to educational clients: The network could be used for remote question-and-answer or training sessions. A corporation, for example, might introduce a new product line by renting time to train and quiz store clerks about how to handle it.

But the primary market is entertainment, GoldPocket says. TV networks could use the service to let millions of viewers vote on, say, which rat-eating survivor to throw off the island.

Unlike other networks that handle multiple tasks, GoldPocket's was designed so it doesn't get jammed up, even when hundreds of thousands of connected players simultaneously hit the Enter key. GoldPocket's theory is that bidders caught up in a live event are more likely to open their wallets than bidders in slow-motion auctions, such as ones currently offered on eBay Inc. and other Web sites.

James Robinson IV, a GoldPocket director, RRE partner and son of the former American Express chief, says before GoldPocket, "nobody had built a backbone that can let a million people play against a game show at the same time." Already, the major TV networks have called GoldPocket to discuss possible deals, he says.

Internet veterans agree that a system that lets huge numbers of people play along, rather than simply view a site, adds a new dimension to the

Please Turn to Page B6, Column 4

GoldPocket Winners*

DATE	NAME	HOMETOWN	OCCUPATION	PRIZE
May 21	**Kelly Balmer**	Springfield, Mo.	Researcher	$1 million
May 28	**Paul Herzog**	Aurora, Ill.	System Engineer	$1 million
June 4	**Larry Rumbough**	Orlando, Fla.	Family Mediator	$1 million
June 11	**Shawna Rosen**	Lenexa, Kan.	Web Site Designer	$500,000
June 18	**Gini Larson**	Grand Ledge, Mich.	Teacher	$500,000

*Winners as of June 24

The Wall Street Journal
June 26, 2000

The Wall Street Journal
June 26, 2000

Internet Quiz Show Gives Away Millions

Continued From Page B1

Web. It could be "incredibly valuable," says Debra McMahon, a consultant with Mercer Management Consulting, in Washington, D.C. "People do like to compete, and if you actually create a competitive community around something, then the site has a franchise."

Mr. Newnam says he came up with the germ of the GoldPocket network a few years ago, while working as treasurer for Irvine Cos., a California real-estate development firm. He came to Harvard in part to work on the project.

There he met Izet Fraanje, a Dutch native who had worked at McKinsey & Co., and at a number of European companies in information technology. Mr. Newnam recruited the 29-year-old Ms. Fraanje, regarded as a formidable brain by her elite peers, to be president and chief operating officer. "She's your basic 200 I.Q.," says Jan Rivkin, a business strategy professor at Harvard who became a director of GoldPocket after the pair graduated last month.

Ms. Fraanje and Mr. Newnam worked through the summer and fall last year installing approximately 100 high-speed Compaq Computer Corp. servers in telecommunications-traffic stations around the country and linking them to the public Internet backbone. After they ran out of their own funds, they raised $700,000 from angel investors in December and a few weeks later secured $8 million from venture-capital firms. In April, they announced a second round of financing totaling $43 million.

Players of the GoldPocket Interactive Trivia game must sign up by Saturday night and download a small software program. On Sunday, at 8 p.m. Eastern time, they log on and are matched up, one on one, each seeing the first name and hometown of his opponent. Players get 12 seconds to answer three multiple-choice questions. If the players tie, they get a fourth question, and the one to answer more quickly advances to the next round.

An in-house team at GoldPocket develops the questions, which are stored, encrypted, on its computer system. A typical question might be: What was the popular name for a group of advisers to Franklin Delano Roosevelt during his early presidency? A: the Best and the Brightest; B: the Ivy Establishment; C: the Columbia Cabal; D: the Brain Trust. (Answer: D.)

When the roughly 16 are done, the one remaining player can choose to keep a $500,000 annuity prize or play a final round to win $1 million. Guess wrong on the final question and the prize is $250,000—also in annuity form, naturally.

The first $1 million winner, 29-year-old Kelly Balmer from Springfield, Mo., says GoldPocket was her chance to use "my vast knowledge of useless trivia." She says she often yearned to play "Jeopardy" but "the tryouts were always in Chicago"—too far away. Ms. Balmer, who cares for her ailing parents, plans to use some of her winnings to hire a nurse so she can pursue her dream of writing children's books.

ATTACHMENT H

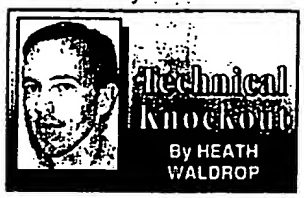
ASHLEY NEWS OBSERVER
CROSSETT, AR
WEEKLY 5,025
JUN 7 2000

Online trivia game has only intangible rewards

6213XY

Well, I didn't win a million dollars on Sunday night.

This should probably go without saying. I also did not win a million dollars the Sunday before that, or the Sunday before that. At least this time, I got a chance to do it.



If you're currently unaware, a company called GoldPocket.com officially began the first-ever million-dollar giveaway online trivia game on Sunday. Live Trivia has actually been in operation since May 21 in the form of two test games, each of which also did give away a million-dollar top prize. But these beta versions were floated out there for the software folks at GoldPocket to get their stuff together, and to catch bugs in the system before the game "officially" began.

I tried to play the first test game on May 21. I downloaded the software and followed the instructions. Before playing time, I opened the game and behold, nothing. It didn't work.

Before the next Sunday, I received an e-mail stating that the Macintosh versions of the software did not work, and that new, "corrected" versions had been released for download. A little perturbed (Mac users have always been treated as second-clas citizens), I got the new software and tried it again on May 28. This time I got as far as the "downloading round one" screen before Live Trivia abruptly went dead.

Again, an apologetic e-mail from GoldPocket last week and a promise that all had been corrected.

These things were in mind as I opened up Live Trivia on Sunday, fully expecting it to not work. I was shocked when it did.

I felt a rush of adrenaline as I correctly answered five of five questions in the qualifying round and was put into the million-dollar round. My high school quiz bowl days came back in a rush.

The way it works is, after initially choosing a category of questioning (I chose arts and entertainment) and answering three of five qualifying questions correctly, you are placed into the million-dollar round. In a tournament style format, you are pitted against each other one-on-one in a three-question series. If the series is tied at three after the third question, you're placed in a Lightning Round where speed on the mouse is critical. If you lose, you are out of the million-dollar round but placed into a consolation round.

I was in the million-dollar round up through three games (of 16 total), and I fell out not because I missed a question, but because I was slower than my opponent in a Lightning Round. I didn't miss a question until Laura Ingalls Wilder got me. "Who wrote the 'Little House' series?" I was asked. I knew the answer, but in my haste I clicked on "Louisa Mae Alcott." OK, three names and three names. It could have been "Charles Nelson Reilly" and I would have probably instinctively clicked it because of the three names.

After falling out of the million-dollar round, I went on a rampage. It seemed as though everyone I played against was from Texas. One by one they fell: Arleene, Jon, Paul, George, Ringo, whatever. Did I get lucky? Yes, on a couple of occasions, I discovered that I don't know enough about Jim Carrey movies to be extremely succesful at Live Trivia. Two of the questions were about him, and I hate Jim Carrey. His movies make my stomach churn. Just by using educated guesses, I was able to get both of them right.

I never lost in another Lightning Round again, though I played several because, quite frankly, the questions were too easy. Not as easy as a hundred-dollar question on "Who Wants to Be a Millionaire?" (which this week included the toughie, "What word is the opposite of 'big'?"), but plenty easy enough for me to miss no more than 10 questions all night.

The game is still not bug-free. I lost one round on a quirk that didn't send my answer to the server, and on another, Live Trivia told me that Robert Louis Stevenson wrote "The Phantom of the Opera." With this behind me, I hit another snag with some drinking questions (a teetotaler has no clue what ingredients are in a Margarita). Then Pam from Austin, Texas, got me on Rembrandt's birthplace, and Ken from somewhere in Illinois whipped me 3-0 in round 15, which was rather embarrassing.

Still, even though I ended with a whimper, the interactivity was fun and a novel idea.

Maybe by next Sunday, I'll be a million dollars richer.

Web contest offers $1 million prize

If you want to call me at 8 p.m. tonight of any Sunday night, don't.

You won't get me; I'm indisposed.

No I'm not "powdering my nose." I'm not watching the Simpsons, either.

I'm playing a trivia game and trying to win big bucks.

Who wants to be a millionaire?

Me.

Every Sunday night goldpocket.com runs a nationwide contest over the Internet. Players are matched up one-on-one in three-question rounds. The person who wins the round is matched up against another winner, tournament style.

At each level, the program tells you the first name of your opponent and the town in which he or she lives - Janet from Greenville, N.C., Shemp from New York, N.Y., Stan from Middletown, Ohio.

You have 11 seconds to answer. Speed doesn't matter, unless you take more than 11 seconds; then it counts as a miss.

Once you click on one of the four choices it's, your "final answer" and there's no going back. Most of the questions (with the exception of the final $1 million question) are not overly hard. Although as Regis Philbin always says, a question is easy only if you know the answer.

If after the three questions, you are tied with your opponent (and this happens frequently), you go into the "lightning round."

Now speed does matter. You and your opponent are given an easy question and the one who answers correctly first is the winner. You have to quickly read the question and the answers.

I've won a lot more of these than I've lost. But I've lost lightning rounds in which I've answered in just 1.85 seconds.

Head-to-head play continues until there is only one player left who has won every round. This takes about 18 rounds.

The winner can take a sure $500,000 or take a chance at one more question. If the player accepts and gets the question right, he or she wins $1 million. If the answer is wrong the prize dips to $250,000.

Unfortunately, the farthest I've ever made it is six rounds before I lost. In fact, last week I lost on the first round (it was the lightning round that got me). But the game is still interesting even after you are out of the running for the $1 million.

Even after losing, you to be matched up with other losing players and receive points for every round you win and for every question you answer correctly. At the end of the month, goldpocket.com holds a drawing for cash. Each point counts for one entry. In July, five players will win $10,000 each.

Most people would wonder how responsive this software is. I certainly didn't expect that with my 56kbs dial-up modem I'd have an equal chance as someone who was hooked up with a T-1 on an ethernet. And could GoldPocket's servers handle the hammering it takes with all these players connected simultaneously?

Amazingly, everything works great.

This game isn't played with a Web browser, although you must use your browser to surf to their site and sign up. If you want to play you must download and install special software, so you must plan ahead if you want to play. I'd recommend you download the software and try it out several hours before game time.

Once the software is installed and working, just start the GoldPocket software by 7:55 p.m. There are some sample questions to practice with before the game starts.

And I wish you luck unless, of course, you find yourself facing Kurt from Carlisle, Pa.

This brings up the two final questions:

How does GoldPocket make its money?

If you play their game, will you e-mail box be filled with spam the next day?

As for making money, they don't seem to be making any yet. While there are a few amazon.com ads, it would take a lot more to pay for the prizes and the hardware they are using. Besides people on the edge of their sets with their fingers poised on their mouse buttons are hardly in a frame of mind to take in any advertising methods.

It appears this well-financed effort is a proof-of-concept. The people behind GoldPocket plan to sell their services or their technology to deep pockets like TV networks to run real-time nationwide interactive events.

And I must say that their technology seems to work a bit better than ABC TV's Enhanced TV. And while good technology is no assurance of success, they seem to be on to something.

It will be interesting to see how well their game does in the fall when the Simpsons stop showing re-runs.

This week's sites:

GoldPocket: www.goldpocket.com
The Simpsons: http://thesimpsons.com/

SENTINEL
CARLISLE, PA
SUNDAY 18,000
JUL 30 2000

ATTACHMENT J

DEMOCRAT AND CHRONICLE
ROCHESTER, NY
SATURDAY 206,780
MAY 20 2000

Web watch

goldpocket.com

Oh, lucky world. First, there was Britain's TV game show, *Who Wants to Be a Millionaire?* Then we ripped it off with a barely-disguised *Who Wants to Be a Millionaire* (no question mark). Then, in almost Cold War-like fashion, Russia launched *Oh, Schastlivchik* ("Oh, Lucky Man").

Now, trivia game shows go global, with tomorrow's debut of the *GoldPocket.com Live Trivia* game show. During this weekly, one-hour show, more than 2 million people can compete simultaneously on a single Web site for a $1 million grand prize. The "pilot" game starts at 8 p.m., at goldpocket.com.

ATTACHMENT K

OBSERVER-REPORTER
(ACCESS SUPPLEMENT)
WASHINGTON, PA
SUNDAY 39,500
JUL 9 2000

/online games/

Who wants to be a dot-com millionaire?

Masters of fast factoid-recall don't have to depend on Regis to win a million bucks. They can now go brain-to-brain online at GoldPocket.com Live Trivia.

This real-time game show—played Sundays at 8 p.m. EDT—randomly matches one player against another. Each round consists of three questions, flashed onscreen along with four possible answers. Click on your final answer, and wait 10 to 20 seconds for the results. Ties are decided with a lightning round. The winner of each round moves on, and rounds continue until only one contestant remains. GoldPocket.com says 2 million people can compete online at the same time.

APPENDIX E

Declaration of Ryan Nelson, Submitted With Reply of March 25, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Jennifer Newnam et al

Serial No. 09/536,518

Examiner: R. Alvarez
Group Art Unit: 3622

Filed: March 22, 2000

Title: A Method and System of Playing and Controlling a Contest for a Large Number of Simultaneous Contestants

Commissioner for Patents
Washington, D.C. 20231

Declaration of Ryan Nelson Under 37 C.F.R. § 1.132

Dear Sir:

In response to the Office Action dated September 27, 2002, I, Ryan Nelson, declare as follows:

1. I currently reside at 1600 Old Ballard Rd., Charlottesville, VA

2. I received a bachelors of science in Public Administration from James Madison University in 1980.

3. I received a M.P.A., specializing in Management Information Systems, from The Ohio State University in 1982.

4. I received a Ph.D. in Business Administration, majoring in Management Information Systems, from the University of Georgia in 1985.

5. I consider myself an expert in the field of information systems, the impact of information technology on organizations and end-user computing.

6. I have been published in such journals as the *MIS Quarterly*; *Communications of the ACM*; *Journal of Management Information Systems*; *Information & Management*; *International Information Systems*; *Data Base*; and *Datamation*. In addition, I edited a book titled *End-User Computing: Concepts, Issues & Applications*, published by John Wiley & Sons.

7. I have served as an information systems consultant to a number of organizations, including the Texas Air Corporation, the Association for Investment Management and Research, Home Federal Savings & Loan, and the Administrative Office of the U.S. Courts.

8. I have been published in a number of information systems journals and books. The following is a select list:

a. "Peopleware: The Hiring and Retention of IT Personnel," in Strategies for Managing IS/IT Personnel, ed. By Conrad Shayo, 2003 (with P. Todd).

b. "Strategies for Managing EUC on the Web," *Journal of End-User Computing*, January-March 1999 (with P. Todd).

c. "The Assessment of End-User Training Needs," *Communications of the ACM*, July 1995 (with E. Whitener and H. Philcox).

d. "Reengineering the IS Function," *Business Process Reengineering: A Managerial Perspective*, 1995 (with H. Smith and J. McKeen).

e. "Perceived Usefulness, Ease of Use, and Usage of Information Technology," *MIS Quarterly*, June 1992 (with D. Adams and P. Todd).

f. "Educational Needs as Perceived by IS and End-User Personnel: A Survey of Knowledge and Skill Requirements," *MIS Quarterly*, December 1991.

g. "Training End Users: An Exploratory Study," *MIS Quarterly*, December 1987 (with P. Cheney).

9. I have reviewed the patent application, identified above, and have reviewed the Office Action of September 27, 2002 and the references cited therein.

10. In my opinion, the references cited in the Office Action, and for that matter all other internet-based systems of which I am aware and which I know to have existed prior to March 22, 2000, are fundamentally different than the GoldPocket game. In my opinion and based on my in-depth knowledge of information systems both at the time of the patent application and currently, the GoldPocket game was unique, new and not obvious.

11. My view is based on the technically unique combination of elements brought together by GoldPocket in the formation of the Live Trivia Game. To my knowledge, never before had someone attempted to assemble an internet-based entertainment system designed to handle the large volume of simultaneous contestants and the related interactions, as envisioned by the game. All Internet entertainment systems prior to March 22, 2000 had been designed to handle users accessing, on their own schedules, content that was available 24/7. GoldPocket's Live Trivia Game provided the excitement of a large number of participants competing with each other by making it an event. Users were instructed to come to the site at 8:00 PM on Sunday evening in order to compete against everyone else who showed up to compete.

12. All standard, internet-based entertainment systems prior to March 22, 2000 group small numbers of users into small competitions as they arrive at an Internet Site, where the users compete for the highest score. GoldPocket realized that one could provide a much more compelling user experience by hosting an event in which large numbers of users would

participate in direct head-to-head competition. In order to host this new type of event, GoldPocket had to develop a new entertainment system capable of (i) allowing extremely large numbers of contestants to simultaneously play the same game, (ii) matching each contestant against another for one round, and then matching the winner against another winner and the loser against another loser, and (iii) determining a single winner within a short enough time period (less than one hour) to make it an exciting community event capable of holding the interest of participants no longer in contention for the winning prize. GoldPocket's unique solution allowed them to provide a game that was not available in any form prior to March 22, 2000.

13. GoldPocket's approach was unique in that it combined new types of timing mechanisms, order of play and methods of tracking participants to make this an experience that was truly unique in the annals of "mass participative communication." It is precisely the combination of holding an event at a particular time, allowing any willing competitor to compete against anyone else who chose to participate, and matching participants in one-on-one competitions that formed a highly unique and entertaining offering.

14. When I first learned of GoldPocket's Live Trivia Game, I thought it was a remarkable idea. Although I have expertise in information systems and was aware of Internet-based multiplayer games (such as those cited in the office action), as far as I was aware, nobody had realized that by following the combination of elements disclosed in this application, one could create a massive game that would allow extremely large numbers of contestants to compete, creating a unique and exciting event. A game on this scale is so different in degree from the type of multiplayer games done prior to March 22, 2000, that it is different in kind.

15. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date 3/20/2013

Ryan Nelson

APPENDIX F

Declaration of Leszek Pawlowicz, Submitted with Reply of March 25, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Jennifer Newnam et al

Serial No. 09/536,518

Examiner: R. Alvarez
Group Art Unit: 3622

Filed: March 22, 2000

Title: A Method and System of Playing and Controlling a Contest for a Large Number of Simultaneous Contestants

Commissioner for Patents
Washington, D.C. 20231

Declaration of Leszek Pawlowicz Under 37 C.F.R. § 1.132

Dear Sir:

In response to the Office Action dated September 27, 2002, I, Leszek Pawlowicz, declare as follows:

1. I currently reside at 428 Shongopovi Trail, Flagstaff Arizona.

2. I received a bachelors of arts *cum laude* with honors in Physics and Astronomy from Wesleyan University, Middletown, CT (1979).

3. I received a Ph.D. in Materials Science and Engineering from the Massachusetts Institute of Technology, Cambridge, MA (1987).

4. I consider myself an expert in games and in the playing of competitive games (especially trivia-based games) in view of at least the following experiences.

5. I have competed in and won the following televised game shows:

a. Jeopardy!, October 1991, five-day winnings of $75,400.

b. Winner of 8th Tournament of Champions, and top prize of $100,000, Jeopardy! (syndicated), November 1992 (defeated best field in Tournament history). I am number 3 on combined 5-day winnings and Tournament of Champions winnings.

c. Win Ben Stein's Money (Comedy Central), August 1999, won top prize of $5,000.

d. Who Wants To Be A Millionaire? (ABC), August 1999 and February 2000 (qualified for televised version using mass telephone qualification; no cash winnings on final televised version).

e. History IQ (History Channel), May and June 2001 - Second place in finals of four-round elimination tournament format. Winnings of $9,100.

f. Who Wants To Be A Millionaire? (syndicated), September 2002 and August 2003 (tentative air date) - On- air "Phone-A-Friend" for contestants participating in the televised version of the show; successfully answered question both times.

6. I have competed in and won the following on-line trivia competitions:

a. Jeopardy! Online and Trivial Pursuit Online - occasional play (Note: Jeopardy Online was mentioned in the patent application specification).

b. Paranoia, April and May 2000 - Online component of Fox Family Channel TV game show. Won $50 and new computer for the best online score.

c. GoldPocket.com, July 2000 - Won top prize of $1 million annuity.

d. HistoryIQ, August 2000 to June 2001 - Won $200 in gift certificates (maximum possible, in $50 increments) for best score in online version of TV game show.

e. The Weakest Link, September 2001 to March 2002 - Regularly achieved high score in simultaneous competition synchronized with on-air game (NBC).

7. I have appeared in or been quoted, in connection with my game playing, in the following:

a. NY Times Sunday Magazine, "The Know it Alls," November 5, 2000, in which I was called "The Michael Jordan of game shows."

b. ABC News 20/20 News Magazine, "Know it Alls," January 5, 2001

c. National Public Radio, "To The Best Of Our Knowledge", February 2001.

d. National Public Radio, "Been There, Done That", September 2002.

e. Numerous other articles and appearances in Arizona media (TV, radio and newspapers), citations can be provided if needed.

8. I have reviewed the patent application, identified above, and have reviewed the Office Action of September 27, 2002 and the references cited therein.

9. In my opinion, the references cited in the Office Action, and for that matter all other games of which I am aware and which I know to have existed prior to March 22, 2000, are fundamentally different than the GoldPocket game. In my opinion and based on my knowledge of games, the GoldPocket game was unique, new and not obvious.

10. My view is based partly on both the time scale of the competition and the number of contestants competing simultaneously. Bringing together enormous numbers of contestants (e.g., tens of thousands or more) for a simultaneous real-time competition via the Internet had not been done prior to GoldPocket's competitions. Previous online games have been limited either in the number of simultaneous competitors, or in the requirement for extended periods of time for play, precisely because coordinating the results from a large numbers of players in real-time is not a trivial task with an obvious solution.

11. All on-line games of which I am aware that existed before March 22, 2000 and that allowed contestants to simultaneously compete against one another had a highly limited number of contestants (e.g., the games cited in the patent office rejection).

12. In my view, <u>if</u> the GoldPocket approach were obvious, there was ample opportunity for others to "beat them to the punch." The Internet existed before GoldPocket, the

game structure used by GoldPocket was known before GoldPocket used it, and the concept of a game having a lot of contestants was known. However, at the time, no one (for whatever reason) seemed to realize or appreciate the idea of putting together a game that would allow an enormous number of contestants to compete simultaneously in a game that would end relatively quickly. This is non-trivial. The excitement generated by the idea of an enormous number of people and the fast game resolution helped ensure that, in fact, a lot of contestants would register and play.

13. The enormous number of people made the game exciting, different and interesting in ways unlike other games. Essentially you would play against anyone who dared, instead of the select few chosen by the management of a game show. Having the game end in a short period made the game exciting in its own unique way, because to win you had to be continually correct without huge breaks (days or weeks) between questions. The above excitement in some sense was instrumental to success. If the game were not exciting, it would be difficult to attract the huge number of contestants. In my view, a key point is that the GoldPocket game was capable of bringing together and in fact brought together a large number of contestants to compete simultaneously in real-time over the Internet.

14. As I noted above, I won a significant sum of money from winning GoldPocket's game. That money, however, has been paid to me already, and my views expressed above have been in no way influenced by winning the game. Moreover, I am being compensated only for my time in preparing this declaration (on a time and materials basis), and my views herein are entirely independent of that compensation. Specifically, I am being compensated at the normal hourly rate that I charge as a Web consultant.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date March 18, 2003

Leszek Pawlowicz